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Supreme Court, U.S.
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NO. _____

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1991

BB ASSET MANAGEMENT, INC., TRANSFEREE
THROUGH BROWN BAG SOFTWARE, INC.

PETITIONER

VS.

SYMANTEC CORPORATION AND JOHN L. FRIEND, AN
INDIVIDUAL AND dba SOFTWORKS DEVELOPMENT

RESPONDENTS

PETITION FOR WRIT OF CERTIORARI TO THE UNITED
STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

I. IS A PARTY TO LITIGATION DEPRIVED OF ITS CONSTITUTIONAL RIGHT TO COUNSEL OF ITS CHOICE UNDER THE FIFTH AND SIXTH AMENDMENTS WHEN THE COURT DENIES THAT PARTY ACCESS TO THE CONFIDENTIAL DOCUMENTS UNDER A PROTECTIVE ORDER IN THE CASE SOLELY BECAUSE THAT PARTY'S TRIAL COUNSEL IS THAT PARTY'S IN-HOUSE GENERAL COUNSEL?

II. IN PERFORMING A COMPARISON OF TWO COMPUTER SOFTWARE PROGRAMS UNDER THE COPYRIGHT LAW TO DETERMINE IF THE TWO PROGRAMS ARE SUBSTANTIALLY SIMILAR:

A. SHOULD THE COURT COMPARE THE OVERALL "LOOK AND FEEL" OF THE TWO PROGRAMS OR MAY THE COURT MERELY COMPARE CERTAIN ELEMENTS OF THE TWO PROGRAMS?

B. SHOULD THE COURT RESOLVE THE IDEA/ EXPRESSION DICHOTOMY BY APPLYING THE ABSTRACTIONS SCALE OF JUDGE LEARNED HAND?

C. SHOULD THE USE OF LAY AND EXPERT OPINION BE ALLOWABLE IN A SINGLE SUBSTANTIAL SIMILARITY INQUIRY?

LIST OF ALL PARTIES

PETITIONERS

BB ASSET MANAGEMENT, INC., A NEVADA CORPORATION, TRANSFEREE OF CERTAIN ASSETS OF BROWN BAG SOFTWARE, INC., INCLUDING PC-OUTLINE, THE COMPUTER SOFTWARE PROGRAM WHICH IS THE SUBJECT OF THIS ACTION. (U.S. BANKRUPTCY COURT, NORTHERN DISTRICT OF CALIFORNIA, SAN JOSE, CASE NUMBER: 59-05537MM.)

RESPONDENTS

SYMANTEC CORPORATION, A DELAWARE CORPORATION, AND JOHN L. FRIEND, AN INDIVIDUAL AND dba SOFTWORKS DEVELOPMENT

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Beutel, Richard Armstrong, Software Engineering Practices and the Idea/Expression Dichotomy: Can Structured Design Methodologies Define the Scope of Software Copyright?, ABA Jurimetrics Journal, Volume 32, Number 1 (Fall 1991) 25, 26, 27

Chisum, Donald S.; Dreyfuss, Rochelle Cooper; Goldstein, Paul; Gorman, Robert A.; Karjala, Dennis S.; Kitch, Edmund W.; Mennell, Peter S.; Rashkind, Leo J.; Reichman, Jerome H. and Samuelson, Pamela, LAST FRONTIER CONFERENCE ON COPY- RIGHT PROTECTION OF COMPUTER SOFTWARE, ABA

Jurimetrics Journal, Volume 30, Number 1 (Fall 1989) 24

Nimmer, Melville B. and Nimmer, David, Nimmer on Copyright, Volume 3, Section 13.03[F], (1991) 26

Wiley, John Sheppard Jr., Copyright at the School of Patent, University of Chicago Law Review, Volume 58, Number 1 (Winter 1991) 22, 23, 35

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IN THE SUPREME COURT OF THE

UNITED STATES OF AMERICA

OCTOBER TERM, 1991

BB ASSET MANAGEMENT, INC., TRANSFEREE THROUGH BROWN BAG SOFTWARE, INC.

PETITIONER

V.

SYMANTEC CORPORATION AND JOHN L. FRIEND, AN INDIVIDUAL AND dba SOFTWORKS DEVELOPMENT

RESPONDENTS

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

Petitioner respectfully requests that a Writ of Certiorari issue to review the judgment and opinion of the United States Court of Appeals for the Ninth Circuit entered in this proceeding on April 7, 1992.

CITATIONS TO OPINIONS BELOW

The opinion of the Court of Appeals, reported as Brown Bag Software, Inc., formerly Telemarketing Resources, Inc., v. Symantec Corp. and John L. Friend, an Individual and dba Softworks Development, 92 Daily Journal D.A.R. 4680 (9th Cir. 1992), appears as Appendix A to this Petition in the form printed by the court below. The page numbers of the appeals court's published opinion differ from those of the foregoing cite.

The final judgment of the District Court for the Northern District of California, reported as Telemarketing Resources, Inc. v. Symantec Corp. and John L. Friend, an Individual and dba Softworks Development (12 U.S.P.Q. 2d (BNA) 1991 (N.D. Cal. 1989), appears as Appendix B to this Petition.

The unpublished written order of the Magistrate "Order on Symantec's Motion for a Protective Order" appears as Appendix C to this Petition.

The unpublished written order of the Judge, "Order Denying Motion for Extension of Discovery Cut-off Date and Denying Motion for Reconsideration of Magistrate's Ruling," appears as Appendix D to this Petition.

JURISDICTION

The opinion of the Court of Appeals for the Ninth Circuit was entered April 7, 1992. This Petition for a Writ of Certiorari was filed within ninety days of that date. This Court's jurisdiction is invoked under 28 U.S.C. Section 1254 (1).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

Article 1, Section 8, Clause 8 of the United States Constitution Appendix E

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STATEMENT OF THE CASE

I. NATURE OF THE CASE

Petitioner shall be referred to throughout this Petition as "Brown Bag" for continuity with the case below. The name "Brown Bag" shall include Brown Bag Software, Inc., BB Asset Management, Inc. and Telemarketing Resources, Inc.

Brown Bag is engaged in the marketing of computer software programs. One of the programs marketed by Brown Bag is PC-Outline, a personal information management system which, among other things, permits its user to organize, store and manipulate information in outline form. Much of PC-Outline's commercial success is attributable to the unique sequence, layout and organization of its features and audiovisual displays.

PC-Outline was created by Mr. John L. Friend ("Mr. Friend") and contains a substantial amount of material wholly original to Mr. Friend. PC-Outline constitutes copyrightable subject matter and is a protected work under the copyright laws of the United States (Certificate of Registration Number TX 1,953,313).

On April 17, 1987, Brown Bag and Mr. Friend entered into a written Purchase and Sale Agreement whereby Brown Bag acquired from Mr. Friend all right, title and interest in and to PC-Outline.

Mr. Friend developed another outlining program, an enhanced or updated version of PC-Outline, which Symantec Corporation ("Symantec") has been marketing under the name of GrandView since approximately April of 1988. (Mr. Friend stated in deposition that his new program initially had been titled PC-Outline 2.)

III. PROCEEDINGS BELOW

This is an action for copyright infringement arising under the Copyright Act of 1976, 17 U.S.C. Section 101 et seq.; the Trademark Law of the United States, 15 U.S.C. Section 1151 et seq.; and for related claims of breached contract, fraud and unfair competition. The district court had jurisdiction of the action under 28 U.S.C. Sections 1331, 1338(a) and the district court's pendant jurisdiction. Venue was proper in the district court under 28 U.S.C. Sections 1391 and 1400(a).

In February 1989, Brown Bag's retained counsel withdrew, and Brown Bag's new in-house general counsel was substituted in as counsel of record/trial counsel. (This substitution took place within 2 or 3 days of counsel's starting with the company.)

Symantec and Mr. Friend objected to providing Brown Bag's new trial counsel with confidential documents under the existing Protective Order which did not distinguish between outside and in-house counsel. On March 8, 1989, the Magistrate entered an Order (Appendix C) which denied Brown Bag's trial counsel access to the confidential material

designated "attorneys' eyes only" or "computer source code" under the Protective Order solely because he was in-house counsel. On April 24, 1989, the Judge entered an order which denied a motion for reconsideration (Appendix D).

Symantec and Mr. Friend moved for summary judgment, and Brown Bag's trial counsel opposed without having had access to the confidential information. On September 7, 1989, the district court entered judgment for Symantec and Mr. Friend on the copyright claim based on a "look and feel" analysis. In its confirming opinion, the appeals court below stated at P. 3729 that "...none of the trade secrets were themselves relevant to Brown Bag's "look and feel" infringement claim, a claim dependent on comparison of the two published programs." However, the first cause of action in Brown Bag's complaint was for copyright infringement which includes infringement by copying source code as well as by copying "look and feel." However, Brown Bag could not pursue the source code copying claim without a copy of GrandView's source code for comparison. Brown Bag was stopped from going forward with a source code copying claim since Brown Bag's counsel was denied access to Grandview's source code.

Brown Bag filed for bankruptcy protection on December 11, 1989. Subsequently, a secured creditor purchased certain assets of Brown Bag, including PC-Outline, at a foreclosure sale, and transferred these assets to the newly formed corporation, BB Asset Management, Inc.

Brown Bag also appealed the district court's decision to the United States Court of Appeals for the Ninth Circuit. On April 7, 1992, the appeals court below filed its opinion upholding:

1) The district court's denial of access to the confidential information under the protective order by Brown Bag's counsel, and

2) The district court's finding of no infringement on the computer software copyright claim.

3) The district court's refusal to admit the declaration of Brown Bag's expert.

The district court below did not evaluate the overall "look and feel" of the two programs. The appeals court below confirmed this approach at P. 3739 of its decision. The appeals court below stated at P. 3732 and P. 3733 of its decision:

> With regard to these five groups of features, the district court concluded that "many of the expressions which plaintiff argues are substantially similar are either not protected under the copyright or were licensed to Mr. Friend." Id. Thus, the court ruled, "[p]laintiff may not rely on these features in proving its case at trial." Id.

However, as is discussed later in this Petition, such features would be considered in an overall "look and feel" evaluation. While various elements may not be copyrightable, the unique combination of these elements may form copyrightable material.

Concerning the idea/expression dichotomy, the district court below stated at P. 1994:

> The idea of a computer run outlining program is undisputedly identical in both GrandView and PC-Outline.

Thus, Judge Learned Hand's "levels of abstraction" analysis was not employed by the district court or by the appeals court in Brown Bag.

The district court stated in Footnote 3 on P. 1994 that Mr. Ogg's declaration, which contained expert opinion as to the similarity of the two programs, would not be admitted. The appeals court stated on P. 3736 and P. 3737:

> To establish infringement of a copyright, the two works in question must also meet the second component of the test set forth in Krofft, the "intrinsic test." 562 F.2d at 1164. The intrinsic test, according to Krofft, should measure "substantial similarity in expressions...depending on the response of the ordinary reasonable person...[I]t does not depend on the type of external criteria and analysis which marks the extrinsic test." Id. (citations omitted). In applying the intrinsic test, therefore, "analytic dissection and expert testimony are not appropriate." Id.

REASONS FOR GRANTING THE WRIT

I. DENIAL OF ACCESS BY TRIAL COUNSEL TO THE CONFIDENTIAL DOCUMENTS UNDER A PROTECTIVE ORDER IN THE CASE SOLELY BECAUSE TRIAL COUNSEL WAS THE PARTY'S IN-HOUSE GENERAL COUNSEL DEPRIVED

THAT PARTY OF ITS CONSTITUTIONAL RIGHT TO COUNSEL OF ITS CHOICE UNDER THE FIFTH AND SIXTH AMENDMENTS.

Right to counsel in criminal cases is guaranteed by the Sixth Amendment and is also within the intendment of the due process of law clause of the Fifth Amendment, Powell v. Alabama, 287, U.S. 45, at Page 66, 53 S.Ct. 55, 77 L.Ed. 158 (1932). Right to counsel in civil cases is no less fundamental, McCuin v. Texas Power & Light Co., 714 F. 2D 1255 (5th Cir. 1983), at Page 1262. In McCuin, the Court stated at P. 1262 (citations omitted):

> Litigants do have a right to be represented by counsel and this ordinarily implies a right to lawyers of their choice. Counsel must be a member of the bar and must be admitted to practice before the court in which he appears. He must not have a conflict of interest with another party. His employment must not entail disclosure of confidential information. The choice is never completely unfettered.

In Brown Bag, the only issue involved the possible disclosure of confidential information. In the district court below, Brown Bag submitted "Plaintiff's Opposition to Defendants' Motion for Protective Order against Disclosure of Defendants' Source Code and Other Highly Confidential Information to Plaintiff's In-house Counsel," dated March 6, 1989. Exhibit A to Plaintiff's Opposition was a declaration in which Brown Bag's trial counsel/in-house general counsel agreed to abide by the Protective Order. He further agreed to retain the confidential information in a locked file cabinet to

which he had the only keys. On P. 2 of his declaration, counsel stated:

> I am neither an officer nor a director of Brown Bag, and I play no management role in the product positioning of Brown Bag. I began employment with Brown Bag only in mid-February, 1989. Insofar as I am aware, I am not related to any other person at Brown Bag.

Exhibit B to Plaintiff's Opposition was a declaration by the President of Brown Bag in which he stated that he had reviewed the Protective Order in the case and the obligations which the Protective Order placed on counsel of record. He said that neither he nor anyone else at Brown Bag not specifically authorized by the Protective Order would attempt to or actually gain access to the confidential information of Defendants/Respondents. Brown Bag's President stated that he would ensure that no one at Brown Bag interfered in any way with the obligations imposed by the Protective Order on in-house counsel.

Brown Bag's President further stated in his declaration that in-house counsel:

1. Was neither an officer nor a director of Brown Bag, and

2. Played no management role in the product positioning of Brown Bag, and

3. Began employment with Brown Bag only in mid-February 1989, and

4. Was not related to any other person at Brown Bag insofar as the President was aware.

The two leading cases involving disclosure of confidential information to in-house counsel under protective orders are U.S. Steel Corp. v. United States, 730 F.2d 1465 (Fed.Cir. 1984) and Matsushita Elec. Indus. Co. v. United States, 929 F.2d 1577 (Fed. Cir. 1991). The Matsushita court applied the U.S. Steel analysis. In both cases, there were both in-house counsel and retained/trial counsel. Thus, even if in-house counsel were to be denied access to the confidential information under the protective orders, retained/trial counsel would have access. In each case, in-house counsel was granted access to the confidential information under the protective order. In the instant case, the in-house counsel was also the trial counsel. Therefore, access to the confidential information was even more critical since there was no outside/trial counsel.

In U.S. Steel, the court stated at P. 1469:

> In further proceedings, access should be denied or granted on the basis of each individual counsel's actual activity and relationship with the party represented, without regard to whether a particular counsel is in-house or retained.

At P. 1468, the U.S. Steel court stated:

> Whether an unacceptable opportunity for inadvertent disclosure exists, however, must be determined, as above indicated, by the courts on a counsel-by-coun-

> sel basis, and cannot be determined solely by giving controlling weight to the classification of counsel as in-house rather than retained.

Again, at P. 1468, the U.S. Steel court stated:

> In a particular case, e.g., where in-house counsel are involved in competitive decision making, it may well be that a party seeking access should be forced to retain outside counsel or be denied the access recognized as needed.

In the Matsushita case, counsel who was granted access was General Counsel, Senior Vice President and Secretary at Tandy Corporation (P. 1579). At P. 1580, the Matsushita court stated:

> These findings are largely irrelevant, since the standard is not "regular contact" with other corporate officials who make "policy", or even competitive decisions, but "advice and participation" in "competitive decision making."

In Brown Bag, the magistrate in the district court stated in the "Order on Symantec's Motion for a Protective Order" at Page 2:

> Under the circumstances of this case in-house counsel is so close to the party that the dangers of inadvertent disclosure of the information is impossible to control.

Also on P. 2 of the Order, the Magistrate stated:

> The plaintiff has sought the removal of its outside counsel and has designated its new and sole in-house counsel as counsel of record in this case. Plaintiff's in-house counsel is the first and only in-house counsel for Brown Bag Software. His responsibilities run the gamut of legal issues from personnel to intellectual property. Although clearly not a management employee, in-house counsel's role is to advise management on all legal issues. He is also the corporation's Human Resource (personnel) person.

Thus, there is no evidence that counsel in the instant case is involved in competitive decision making. The Magistrate had reached a decision solely on the basis of counsel's position as in-house counsel and the general responsibilities of such a position. The appeals court below stated at P. 3728:

> For example, Brown Bag's counsel could not advise his employer on beta tester employment or other marketing strategies that might relate to information he had learned about Symantec's beta tester program or its development and promotion plans for GrandView.

Such a restriction would be acceptable. There was no evidence that counsel's duties would include providing such advice. If asked to provide such advice, counsel could have explained that he was bound by the Protective Order. Both Brown Bag's President and counsel had submitted the declarations described previously which stated that Brown Bag's in-house general counsel was not involved in product positioning. Brown Bag's President had also stated in his declaration that he would ensure that no one at Brown Bag

interfered in any way with the obligations imposed by the Protective Order on in-house counsel.

Brown Bag's counsel was an attorney admitted to practice in California and in Federal courts. He was bound by the same ethical obligations and rules of professional conduct as outside counsel. There was no basis to question trial counsel's ability to discharge his obligations under the Protective Order beyond the mere fact that trial counsel was Brown Bag's in-house general counsel.

Both Brown Bag's President and counsel had submitted the declarations described previously which stated that BROWN BAG'S IN-HOUSE GENERAL COUNSEL WAS NOT INVOLVED IN PRODUCT POSITIONING. There was no evidence that counsel was involved in competitive decision making or would disclose the confidential information during the course of his duties. In U.S. Steel, 730 F.2d at P. 1469, the court stated:

> The certified question (whether access may be granted to retained and denied to in-house counsel solely on a presumption that inadvertent disclosure by the latter is more likely) is answered in the negative, i.e., a denial of access sought by in-house counsel on the sole ground of their status as in-house counsel is error.

In the instant case, the appeals court below engaged in speculation at P. 3728 regarding possible involvement in competitive decision making even after both Brown Bag's counsel and Brown Bag's president submitted declarations

agreeing to protect the confidential information as required by the Protective Order and declaring that counsel played no role in product positioning.

The Magistrate's Order allowed an independent consultant to review and advise on issues involving the confidential documents. However, this was not a viable alternative. Trial counsel cannot effectively represent his client if shown only certain documents selected by a consultant. Trial counsel is responsible for effectively going forward with the client's case. To make informed decisions regarding case management, counsel must evaluate all aspects of a case to determine strengths and weaknesses. Since Respondents' trial counsel had access to all of Brown Bag's confidential documents under the Protective Order, the parties still would not have been on an equal footing. This does not consider the added cost to Brown Bag of paying the consultant. As it was, Brown Bag filed for bankruptcy protection.

Petitioner respectfully requests this honorable Court to recognize that in-house counsel and retained counsel are members of the same bar, subject to the same rules of professional conduct, and are to be judged by the same standards.

If this honorable Court returns this case to the trial court, Petitioner respectfully requests that discovery be reopened for a period of at least 90 days to return Brown Bag to an equal footing.

II. IN PERFORMING A COMPARISON OF TWO COMPUTER SOFTWARE PROGRAMS UNDER THE COPY-

RIGHT LAW TO DETERMINE IF THE TWO PROGRAMS ARE SUBSTANTIALLY SIMILAR, THE OVERALL "LOOK AND FEEL" OF THE TWO PROGRAMS SHOULD BE COMPARED, JUDGE LEARNED HAND'S ABSTRACTION SCALE SHOULD BE APPLIED TO THE IDEA/EXPRESSION DICHOTOMY AND BOTH LAY AND EXPERT OPINION SHOULD BE ALLOWABLE IN A SINGLE SUBSTANTIAL SIMILARITY INQUIRY.

The source of Congress' authority to enact copyright laws is the Constitution of the United States, Article I, Section 8, Clause 8. The copyright laws are found in 17 U.S.C. Section 101, et seq. Sections 101, 102 and 103 are of particular interest in the instant case.

Certiorari should be granted to correct the outcomes in the courts below and to standardize copyright law among the circuits as applied to computer software programs, particularly in the area of what has become known as "look and feel." Computer software has grown into a major industry and has become an important segment of the U.S. economy. Computer software is an important export. The courts have struggled to adapt copyright law to protect this important part of our economy. Leading edge developments have been taking place in the area of "look and feel."

In Johnson Controls v. Phoenix Control Systems, 886 F.2d 1173 (9th Cir.1989), the appeals court below stated at P.1175:

> Computer software is subject to copyright protection. 17 U.S.C. Section 101. A computer program is made up of several different components, including the source and object code, the structure, sequence and/or organization of the program, the user interface, and the function, or purpose, of the program. Whether a particular component of a program is protected by a copyright depends on whether it qualifies as an "expression" of an idea, rather than the idea itself. See Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 547, 105 S.Ct. 2218, 2223, 85 L.Ed.2d 588 (1985); Data East USA, Inc. v. Epyx, Inc., 862 F.2d 204, 207-08 (9th Cir. 1988); 17 U.S.C. Section 102(b). (Footnotes omitted.)

The omitted footnotes are as follows:

> The source code is a set of instructions to the computer, in languages such as BASIC, or FORTRAN. The object code is the same set of instructions, but in binary code, a series of 1's and 0's, which the computer reads.
>
> The user interface, also called the "look and feel" of the program, is generally the design of the video screen and the manner in which information is presented to the user.

The district court stated in Brown Bag at P. 1993:

> Copyright protection applies to the user interface, or overall structure and organization of a computer program, including its audiovisual displays or screen "look and feel." Whelan Associates, Inc. v. Jaslow Dental Laboratory, Inc., 797 F.2d 1222, 1234 [230 USPQ 481, 488-89] (3d Cir. 1986); Broderbund Soft-

ware v. Unison World, 648 F. Supp. 1127 [231 USPQ 700] (N.D. Cal. 1986).

Computer lawyer Douglas Derwin, Esq. stated in an article which appeared at P. 6 of The Recorder of March 19, 1990:

> . . . Jack Russo of Fenwick, Davis & West (now of Nelson & Russo) invented the concept of "look and feel" protection, which he defined as copyright protection over the manner in which a computer program appears to a user, including screen displays and the general manner in which the program operates.

The district court stated in Brown Bag at P. 1996:

> The allegedly infringing work encompasses the same idea and performs the same general function as plaintiff's PC-Outline.

The district court stated in Brown Bag at P. 1994: "The idea of a computer run outlining program is undisputedly identical in both GrandView and PC-Outline."

In Brown Bag, the appeals court affirmed the district court's method of "analytic dissection" and indicated that an evaluation of the "overall look and feel" was not required, Brown Bag at P. 3739. At P. 3737, the appeals court stated:

> Under the reformulated extrinsic test, we mean to perpetuate "analytic dissection" as a tool for comparing not only ideas but also expression. Thus, it was not error for the court to use "analytic dissection" in comparing the expressions of the two programs.

In Brown Bag, the district court stated at P. 1996:

> After redacting that material which is not protected under the copyright, or which has been licensed to Mr. Friend, the court performed the required extrinsic and intrinsic tests mandated by law.

Regarding the material which was licensed to Mr. Friend by means of the Purchase and Sale Agreement, that Agreement states at P. 6 and P. 7 that:

> Nothing in this Agreement will be construed as ... any implied right to use the "look and feel" of the Program...

Petitioner contends that the court should have applied a test which compared the "look and feel" of the two programs as a whole. In Atari, Inc. v. North American, Etc., 672 F. 2d 607 (7th Cir. 1982), the court stated at P. 614 and P. 615 concerning the ordinary observer test and analytic dissection:

> It has been said that this test does not involve "analytic dissection and expert testimony," Arnstein, 154 F.2d at 468, but depends on whether the accused work has captured the "total concept and feel" of the copyrighted work, Roth Greeting Cards v. United Card Co., 429 F. 2d 1106, 1110 (9th Cir. 1970).
>
> While dissection is generally disfavored, the ordinary observer test, in application must take into account that the copyright laws preclude appropriation of only those elements of the work that are protected by copyright. (Citations omitted.)

At P. 619 and P. 620, the Atari, Inc. court said:

> Based on an ocular comparison of the two works, we conclude that plaintiffs clearly showed likelihood of success. Although not "virtually identical" to PAC-MAN, K.C. Munchkin captures the "total concept and feel" of and is substantially similar to PAC-MAN.

At Page 618, the Atari, Inc. court said:

> When analyzing two works to determine whether they are substantially similar, courts should be careful not to lose sight of the forest for the trees. Hoehling, 618 F. 2d at 979-80.

Various elements may not be copyrightable, yet the unique combination of these elements may form copyrightable material. In Roulo v. Russ Berrie & Co., 886 F. 2d 931 (7th Cir. 1989), the court stated at P. 939:

> Berrie insists that the jury was allowed to consider elements of similarity unprotected by copyright laws, such as the size of the cards, the color of the paper, ink, and border designs, the general concept of stripes, the ellipses and the single-side format. While it is true that these elements are not individually capable of protection, just as individual words do not deserve copyright protection, it is the unique combination of these common elements which form the copyrighted material. The district court correctly instructed the jury by adopting the defendant's proposed instruction that the common elements noted above are not copyrightable, adding that "[t]he combination of these elements in an arrangement or layout is entitled to copyright protection, however, if you

find that arrangement or layout to be original and unique.

Sem-Torq,Inc. v. K Mart Corp.,936 F. 2d 851 (6th Cir. 1991), is a case involving compilations under 17 U.S.C. 103. The Sem-Torq court stated at P. 855:

> Sem-Torq's signs, then, may only be protected if the set is original. "A copyrightable compilation can consist mainly or entirely of uncopyrightable elements," Harper House, Inc. v. Thomas Nelson, Inc., 889 F. 2d 197, 204 (9th Cir. 1989), because "it is the unique combination of these common elements which form the copyrighted material," Roulo v. Russ Berrie & Co., 886 F. 2d 931,939 (7th Cir. 1989), cert. denied, ---U.S.---, 110 S. Ct. 1124, 107 L. Ed. 2d 1030 (1990); see also Sargent v. American Greetings Corp., 588 F. Supp. 912, 919 (N.D. Ohio 1984).

Thus, in comparing works as a whole, even the uncopyrightable elements are to be included in the comparison.

There are similarities between operating a program such as PC-Outline and operating a video game in that each has audiovisual displays, and each goes through a sequence as the operator interfaces with the program. In Atari Games Corp. v. Oman, 888 F. 2d 878 (D.C. Cir. 1989), the court said at P. 883::

> The Act, however, uses the definitional term "series of related images," 17 U.S.C. Sect. 101, and the case law correspondingly indicates that the Register's focus, even if initially concentrated on discrete parts, ultimately should be on the audiovisual work as a

whole, i.e., the total sequence of images displayed as the game is played.

In Stern Electronics, Inc. v. Kaufman, 669 F. 2d 852 (2nd Cir. 1982), the court said at P. 855 in discussing a "knock-off" that:

> ...replicates precisely the sights and sounds of the game's audiovisual display. This could be done by writing a new computer program that would interact with the hardware components of a video game to produce on the screen the same images seen in "Scramble," accompanied by the same sounds. Such replication is possible because many different computer programs can produce the same "results," whether those results are an analysis of financial records or a sequence of images and sounds. A program is simply "a set of statements [i.e., data] or instructions to be used directly or indirectly in a computer in order to bring about a certain result," Pub. L. No. 96-517, Sect. 10(a), 94 Stat. 3015, 3028 (1980) (amending 17 U.S.C. App. Sect. 101 (1976)). To take an elementary example, the result of displaying a "4" can be achieved by an instruction to add 2 and 2, subtract 3 from 7, or in a variety of other ways. Obviously, writing a new program to replicate the play of "Scramble" requires a sophisticated effort, but it is a manageable task.

In his article titled "Copyright at the School of Patent," University of Chicago Law Review, Volume 58, Number 1, Winter 1991, John Shepard Wiley Jr., Professor of Law, UCLA (hereinafter "Prof. Wiley") stated at P. 121:

> The most notorious problem in copyright law is the idea/expression dichotomy. The Supreme Court launched this doctrine more than a century ago. Congress codified it in 1976, making clear that it sought to restate rather than to alter, the judicial doctrine. (Footnotes omitted.)

In Harper & Row.Publishers v. Nation Enterprises, 471 U.S. 539, 85 L. Ed. 588, 105 S. Ct. 2218, this Court stated that copyright was limited to expression and not ideas. In Feist Pub. v. Rural Tel. Serv., 113 L. Ed. 358 (1991), this Court stated at P. 372:

> This principle, known as the idea/expression or fact/expression dichotomy, applies to all works of authorship.

Prof. Wiley, supra, states at P. 122:

> Although simple to recite, this basic rule is difficult to make concrete. In a telling omission, Congress failed to define the key terms "idea" and "expression." The leading judicial effort to give meaning to the terms is Judge Learned Hand's abstractions test...

Prof. Wiley, id., went on to quote Judge Hand from Nichols v. Universal Pictures Corp., 45 F. 2d 119 (2d Cir. 1930) at P. 121:

> Upon any work, and especially upon a play, a great number of patterns of increasing generality will fit equally well, as more and more of the incident is left out. The last may perhaps be no more than the most general statement of what the play is about, and at

> times might consist only of its title; but there is a point in this series of abstractions where they are no longer protected, since otherwise the playright could prevent the use of his "ideas" to which, apart from their expression, his property is never extended.

The Conference Report, "LAST FRONTIER CONFERENCE ON COPYRIGHT PROTECTION OF COMPUTER SOFTWARE," Donald S. Chisum, Rochelle Cooper Dreyfuss, Paul Goldstein, Robert A. Gorman, Dennis S. Karjala, Edmund W. Kitch, Peter S. Menell, Leo J. Raskind, Jerome H. Reichman and Pamela Samuelson, ABA Jurimetrics Journal, Fall 1989, Volume 30, Number 1, states at P. 20:

> The Third Circuit's decision in Whelan Assocs. v. Jaslow Dental Labs., Inc., 797 F. 2d 1222 (1986), does not take all of these basic principles of copyright law into account. The court sought to implement the idea/expression distinction by making the idea coterminous with the "purpose" of the program. The opinion fails to provide more than an unduly restrictive conclusion about the idea/expression distinction, stating that "the purpose or function of a utilitarian work would be the work's idea, and everything that is not necessary to that purpose or function would be part of the expression." 797 F. 2d at 1236. In applying this test, the court defined the purpose of the plaintiff's program as the "efficient organization of a dental laboratory" and found that "there are a variety of program structures through which that idea can be expressed." 797 F. 2d at 1240. This approach employs an overly narrow interpretation of the term "idea" in Section 102(b) of the Copyright Act and omits systematic consideration of whether program similarities are unprotectible as "procedure, process, system,

> method of operation, concept, principle, or discovery." To the extent that the idea/expression distinction reflects a determination of the level of competition desirable in regard to the subject matter under consideration, as numerous courts have suggested, this formulation restricts competition more broadly than would be the case even in regard to traditional works of art and literature.

A similar result occurred in Brown Bag at P. 3739 of the appeals court's opinion below. The district court in Brown Bag stated at P. 1994:

> The idea of a computer run outlining program is undisputedly identical in both GrandView and PC-Outline.

While the district and appeals courts below followed Whelan, in Plains Cotton Co-op. v. Goodpasture Computer Serv., 807 F.2d 1256 (5th Cir. 1987), at P. 1262 the court declined to embrace Whelan. In his article titled "Software Engineering Practices and the Idea/Expression Dichotomy: Can Structured Design Methodologies Define the Scope of Software Copyright?," ABA Jurimetrics Journal, Fall 1991, Volume 32, Number 1, Richard Armstrong Beutel (hereinafter "Mr. Beutel") states at P. 18:

> Whelan's clearly very broad interpretation of the idea/expression dichotomy has been criticized extensively. Problems with Whelan's broad holding quickly emerged, and took specific form in the Fifth Circuit's subsequent decision in Plains Cotton Coop. Ass'n. v. Goodpasture Computer Serv., Inc. Founded

upon Judge Higgenbotham's opinion in Synercom Technology, Inc. v. University Computing Co., The Plains Cotton court declined to follow the broad holding of Whelan by reaffirming Judge Hand's "level of abstractions" test.

Mr. Beutel, id., states at P. 19:

> While the final judicial outcome of the split between the Third and Fifth Circuits is far from clear, most commentators side with the Fifth Circuit's narrower reading of the scope of software copyright. Most commentators take the view that the Third Circuit's rejection of the abstractions test is simplistic and unworkable, providing, as it does, a single identification of the unprotected idea (the end user application or function). (Footnotes omitted.)

Mr. Beutel, id., goes on to quote from Nimmer on Copyright, Section 13.03[F] (1991) at P. 13-78.33 and P. 13-78.34:

> The crucial flaw in [the reasoning of the Whelan court]...is that it assumes that only one "idea," in copyright law terms, underlies any computer program, and that once a separable idea can be identified, everything else must be an expression. All computer programs are intended to cause the computer to perform some function. The broad purpose that the program serves, be it managing a dental laboratory, automating a factory, or dispensing cash at a bank teller machine, is an idea. Other elements of the program's structure and design, however, may also constitute ideas for copyright purposes.

Further to the "levels of abstraction" analysis, Mr. Beutel, id., states at P. 20:

> Assuming the Fifth Circuit view prevails (despite obstacles posed by more recent cases such as Pearl Systems v. Competition Electronics), the "levels of abstractions" process should become the primary analytic vehicle for the parsing of software code into its protectible elements. Once the software has been parsed into its constituent "ideas" and "expressions," the courts may make a reasoned analysis under the "substantial similarity" requirement to determine if software copyright has been in fringed.
>
> At least two distinct methodologies have been proposed in the commentary defining an approach for the "level of abstractions" test to software code. Both approaches advocate a specific methodology in examining software to resolve the idea/expression dichotomy. The first, suggested by Mssrs. Bernacchi, Frischling, and Nimmer, involves the Successive Filtering of software code to eliminate unprotectible ideas. This "Successive Filtering" test screens software code at each level of abstraction to eliminate unprotectible expression. Central to this approach are the "filters" themselves, which are based upon several different copyright law doctrines clarifying the idea/expression dichotomy.
>
> The second approach, suggested by Gary Reback and David Hayes, advocates a "rule of reason" methodology under the "Abstractions Test." This Abstractions Test seeks to balance the creativity of the software author with the scope of the ensuing copyright monopoly.

Lotus Development Corp. v. Paperback Software Intl., 15 USPQ 2d (D. Mass. 1990), was a computer software copyright infringement action involving an electronic spreadsheet program. Spreadsheet programs, such as Lotus 1-2-3, and outlining programs, such as PC-Outline are similar in that both begin with essentially blank screens, and the users create spreadsheets or outlines in which the users insert their own information.

In Lotus, the court spent considerable effort attempting to distinguish between idea and expression and reviewed, at P. 1593, the attempt of Judge Learned Hand. The Lotus court stated the most significant elements of the legal test for copyrightability as:

> FIRST, in making the determination of "copyrightability," the decision maker must focus upon alternatives that counsel may suggest, or the court may conceive, along the scale from the most generalized conception to the most particularized, and choose some formulation - some conception or definition of the "idea" - for the purpose of distinguishing between the idea and its expression.
>
> SECOND, the decision maker must focus upon whether an alleged expression of the idea is limited to elements essential to expression of that idea (or is one of only a few ways of expressing the idea) or instead includes identifiable elements of expression not essential to every expression of that idea.
>
> THIRD, having identified elements of expression not essential to every expression of the idea, the decision

maker must focus on whether those elements are a substantial part of the allegedly copyrightable "work."

The Lotus court went on to state at P. 1599:

> The fact that some of these specific command terms are quite obvious or merge with the idea of such a particular command term does not preclude copyrightability for the command structure taken as a whole. If particular characteristics not distinctive individually have been brought together in a way that makes the "whole" a distinctive expression of an idea -- one of many possible ways of expressing it -- then the "whole" may be copyrightable.

In Brown Bag,, the district court below stated at P. 1995:

> Inherent in the idea of an outlining program is the need to access existing files, edit the work, and print the work. These concepts are fundamental to a host of computer programs. Nevertheless, plaintiffs assert that the presence of these four options in the menu screen demonstrates substantial similarity of expression. This expression is unprotectable.

Thus, the district court in Brown Bag did not look at the command structure as a whole as did the Lotus court which stated (see above) that characteristics not distinctive individually may be brought together in a way that makes the "whole" a distinctive expression of an idea.

The Lotus court considered menus at P. 1599:

> This particular expression of a menu structure is not essential to the electronic spreadsheet idea, nor does it merge with the somewhat less abstract idea of a menu structure for an electronic spreadsheet. The idea of a menu structure -- including the overall structure, the order of commands in each menu line, the choice of letters, words, or "symbolic tokens" to represent each command, the presentation of these symbolic tokens on the screen (i.e., first letter only, abbreviations, full words, full words with one or more letters capitalized or underlined), the type of menu system used (i.e., one-,two-, or three-line moving-cursor menus, pull-down menus, or command-driven interfaces), and the long prompts -- could be expressed in a great many if not literally unlimited number of ways.

In Brown Bag, the district court below stated at P. 1995:

> Apparently, plaintiff is also asserting the use of pull down windows as a similarity. This idea is employed in a number of computer programs, including MORE! and ThinkTank. Plaintiffs may not claim copyright protection of an idea and expression that is, if not standard, then commonplace in the computer software industry. Plaintiff's copyright validly covers only "original works of authorship." (Citations omitted.)

Concerning its program comparison test and the use of expert witnesses, the appeals court below in Brown Bag stated at P. 3733 and P. 3744:

> In this court's leading copyright infringement case, we held that, in assessing the similarity of two works, expert testimony is appropriate in some respects and inappropriate in others. Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp., 562 F. 2d 1157, 1164 (9th Cir. 1977). Initially, the line was drawn between comparing ideas embodied in a work, for which expert testimony was appropriate, and comparing the works' respective expressions of common ideas, for which expert testimony was thought inappropriate. Id. Recently, however, we have recognized that the line is more properly drawn between objective and subjective analyses of expression. Shaw v. Lindheim, 919 F. 2d 1353, 1357 (9th Cir. 1990). As such, expert opinion is relevant not only to the analysis of ideas behind two works but also to the objective analysis of expression.

Yet, in Brown Bag at P. 3734, the appeals court below stated that the district court had considered the declaration of Brown Bag's expert, Mr. Ronald Ogg ("Mr. Ogg"), to the full extent permitted under our circuit's law. In the instant case, the district court stated in Footnote 3 on P. 1994 that Mr. Ogg's declaration, which contained expert opinion as to the similarity of the two programs, would not be admitted.

Mr. Ogg's declaration, executed on May 3, 1989, states on P. 3 and P. 4:

> Even a brief comparison of THINKTANK and GRANDVIEW shows that the user interface of GRANDVIEW is not derived in any significant way from THINKTANK. Among a long litany of differences which could be identified, the shades of blue

used are different, no menu bar is used, the bulk of the commands are different, and no support for multiple outline windows is possible. In my opinion, no reasonable person could conclude that THINKTANK and GRANDVIEW have a substantially similar "look and feel", as that term is used in the context of computer software.

However, PC OUTLINE and GRANDVIEW have extremely similar user interfaces, and have virtually the same look and feel. Moreover, a number of the features common between PC OUTLINE and GRANDVIEW are unique to these two programs, and no other program has so similar a combination of features which make up the user interface. Virtually every function performed by PC OUTLINE is also performed by GRANDVIEW, often in a virtually identical way. Where the steps used to perform the feature differ in GRANDVIEW, the change seems to be primarily cosmetic. It is correct that GRANDVIEW offers features additional to those offered by PC OUTLINE; however, this would be expected in any program derived from an earlier program, and does not conflict with my opinion that GRANDVIEW is substantially similar to PC OUTLINE, at least as to the look and feel of the user interface. Stated differently, in my opinion the look and feel of GRANDVIEW is substantially similar to and was derived from the look and feel of PC OUTLINE.

In addition, a newspaper article, attached to the declaration of Brown Bag's President which was submitted in association with summary judgment, gave the author's comparison of the "look and feel" of PC-Outline and Grand-

View. The appeals court below stated at P. 3734 of its decision in Brown Bag:

> Brown Bag also contends that the district court rejected the declaration of Sanford B. Schupper, Brown Bag's president. Symantec and Friend objected to the admission of exhibits of newspaper articles attached to Schupper's declaration. The district court did not rule on Symantec's and Friend's objection. Neither did it reference Schupper's declaration or the exhibits in its order granting summary judgment. On this record, Brown Bag can point to no rejection or denial of the affidavit to appeal.

In Arnstein v. Porter, 154 F.2d 464, the court stated at P. 468:

> If there is evidence of access and similarities exist, then the trier of the facts must determine whether the similarities are sufficient to prove copying. On this issue, analysis ("dissection") is relevant, and the testimony of experts may be received to aid the trier of the facts.
>
> If copying is established, then only does there arise the second issue, that of illicit copying (unlawful appropriation). On that issue (as noted more in detail below) the test is the response of the ordinary lay hearer; accordingly, on that issue, "dissection" and expert testimony are irrelevant. (Footnote omitted.)

In Whelan Associates v. Jaslow Dental Laboratory, 797 F.2d 1222 (3rd Cir. 1986), the court stated at P. 1232 and P. 1233:

The district court heard expert testimony. See supra 1228; infra at 1246-48. It did not bifurcate its analysis, however, but made only a single finding of substantial similarity. See Whelan Associates v. Jaslow Dental Laboratory, 609 F.Supp. at 1321-22. It would thus appear to have contravened the law of this circuit. Nevertheless, for the reasons that follow, we believe that the district court applied an appropriate standard.

The ordinary observer test, which was developed in cases involving novels, plays, and paintings, and which does not permit expert testimony, is of doubtful value in cases involving computer programs on account of the programs' complexity and unfamiliarity to most members of the public.

Moreover, the distinction between the two parts of the Arnstein test may be of doubtful value when the finder of fact is the same person for each step: that person has been exposed to expert evidence in the first step, yet she or he is supposed to ignore or "forget" that evidence in analyzing the problem under the second step. Especially in complex cases, we doubt that the "forgetting" can be effective when the expert testimony is essential to even the most fundamental understanding of the objects in question.

On account of these problems with the standard, we believe that the ordinary observer test is not useful and is potentially misleading when the subjects of the copyright are particularly complex, such as computer programs. We therefore join the growing number of courts which do not apply the ordinary observer test in copyright cases involving exceptionally difficult materials, like computer programs, but instead adopt

a single substantial similarity inquiry according to which both lay and expert testimony would be admissible.

Prof. Wiley, supra, states at P. 129:

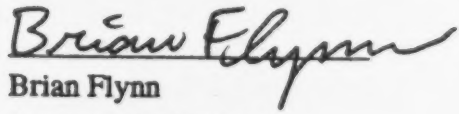
A second core problem in the law of copyright concerns the use of expert opinion in infringement cases. The variety of judicial attitudes is remarkable. Some courts demonstrate absolutely no interest in either highlighting or limiting the use of expert opinion. Other courts banish experts altogether. Still other courts set forth involved and separate roles for expert and lay opinions, even while disagreeing with each other about the definition of these roles. To complete the circle, other courts defer completely to expert opinion on the matter of copyright infringement. Yet for all this diversity of attitude, the cases offer no understanding of the consequences at stake or the considerations that ought to control.

CONCLUSION

For these reasons, a writ of certiorari should issue to review the judgment and opinion of the Court of Appeals in this matter. Petitioner respectfully requests attorney's fees for this appeal pursuant to 17 U.S.C. 505 and costs. Petitioner further respectfully requests that that the costs assessed by the district and appeals courts below be reversed.

Dated: June 25, 1992

Respectfully Submitted,



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NOTE: The page numbers of the foregoing cite differ from those of the printed opinion of the appeals court below which is included in the Appendix.

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APPENDIX A

Opinion, United States Court of Appeals for the Ninth Circuit (April 7, 1992) [Brown Bag Software V. Symantec Corp. and John L. Friend, an individual and dba Softworks Development, 92 Daily Journal D.A.R. 4680 (9th Cir. 1992)]

NOTE: Page numbers in this Appendix A are those of the court's published opinion and differ from those of the foregoing Daily Journal cite.

FOR PUBLICATION

UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

BROWN BAG SOFTWARE, a California corporation, formerly Telemarketing Resources, Inc.,
Plaintiff-Appellant,

v.

SYMANTEC CORP., a California corporation; JOHN L. FRIEND, an individual and dba Softworks Development,
Defendants-Appellees.

No. 89-16239

D.C. No. CV-88-20352-RPA

OPINION

Appeal from the United States District Court
for the Northern District of California
Robert P. Aguilar, District Judge, Presiding

Argued and Submitted
February 14, 1991—San Francisco, California

Filed April 7, 1992

Before: Joseph T. Sneed, Thomas Tang and David R. Thompson, Circuit Judges.

Opinion by Judge Tang; Concurrence by Judge Sneed

SUMMARY

Courts and Procedure/Intellectual Property

Affirming in part, vacating in part and remanding a district court grant of summary judgment on a copyright infringe-

ment, the court of appeals held that the district court had properly issued a protective order restricting the access of appellant's in-house counsel to confidential trade information produced during discovery.

Appellant Brown Bag Software sued Symantec Corp. and John L. Friend for infringement of Brown Bag's registered copyright in a computer program for outlining. The district court granted Symantec's motion for a protective order restricting the access of Brown Bag's in-house counsel to the documents labelled "attorneys' eyes only" under the parties' previous stipulation. However, the order provided that Brown Bag could have access only through an "independent consultant," legal or otherwise. The district court granted summary judgment for Symantec.

[1] In this case, the court had to balance the risk to Symantec of inadvertent disclosure of trade secrets to competitors against the risk to Brown Bag that protection of Symantec's trade secrets impaired prosecution of its claims. [2] Proper review of protective orders in cases such as this required the factual examination of all the risks and safeguards surrounding inadvertent disclosure by any counsel, whether in-house or retained. In addition, the nature of the claims and of a party's opportunity to develop its case through alternative discovery procedures factors into decisions on the propriety of such protective orders. [3] Here, a magistrate reasonabley concluded that Brown Bag's counsel's employment would necessarily entail advising his employer in areas relating to Symantec's trade secrets. [4] In addition, the magistrate weighed not only the risk of disclosure to Symantec, but also the potential impairment of Brown Bag's case against Symantec. Thus, the magistrate adequately considered the hardship a protective order might impose on Brown Bag's prosecution of its claims. [5] Brown Bag's assertion that the protective order unfairly hindered its opposition to summary judgment was too speculative to establish that the protective order was an abuse of discretion. Brown Bag failed to show

how the protective order actually could have or did prejudice its case.

[6] Summary judgment for a defendant accused of copyright infringement is appropriate when the plaintiff fails to show a genuine issue regarding whether the ideas and expressive elements of the works are substantially similar. [7] In assessing the similarity of two works, expert testimony is appropriate in some respects and inappropriate in others. [8] Here, the district court relied on a disputed affidavit to identify objective components for comparison. The district court therefore considered the declaration of Brown Bag's expert to the full extent permitted under Ninth Circuit law. In addition, Brown Bag failed to establish that the district court's decision not to credit the opinion expressed in the affidavit more fully prejudiced Brown Bag.

[9] Brown Bag was entitled to a presumption of originality in its computer outline copyright because it was registered. [10] Brown Bag's argument that the district court erred in holding this presumption rebutted was meritless. [11] In addition, it was not error for the district court to use "analytic dissection" in comparing the expressions of the two computer programs in question. [12] Analytic dissection is used not for the purposes of comparing similarities and identifying infringement, but for the purpose of defining the scope of plaintiff's copyright. [13] Because the district court found that Brown Bag made no showing of similarity with regard to copyrighted components of the computer outline program, summary judgment was not precluded by *Shaw*.

[14] Although the district court dismissed Brown Bag's pendent state claims because it had granted summary judgment to Symantec and Friend on its federal claims, the district court's order did not even mention the Lanham Act claim. [15] The court refused to infer a district court's decision on an entire claim and to rewrite the trial court's judgment to include the inferred decision. Thus, the court remanded the

Lanham Act claim for clarification and determination by the district court.

Judge Sneed concurred separately in Parts I and III of the court's opinion, and in the judgment regarding Part II. Judge Sneed believed that *Shaw* provides a poor analytic strucure by which to determine the substantial similarity of an allegedly infringing computer program.

COUNSEL

Brian Flynn, Sunnyvale, California, for the plaintiff-appellant.

Gary L. Reback, Fenwick, Davis & West, Palo Alto, California, for the defendants-appellees.

OPINION

TANG, Circuit Judge:

Brown Bag Software ("Brown Bag") sued Symantec Corp. ("Symantec") and John L. Friend for infringement of Brown Bag's registered copyright in a computer program for outlining. The district court entered a protective order restricting the access of Brown Bag's in-house counsel to confidential trade information produced during discovery. The district court subsequently granted Symantec's and Friend's motions for summary judgment. Brown Bag appeals the protective order and the grant of summary judgment. We affirm-in-part, vacate-in-part and remand.

FACTUAL AND PROCEDURAL BACKGROUND

In 1983, Symantec developed and marketed the first successful outlining program, "ThinkTank." By 1985, Symantec

had developed and marketed two more outlining programs, "Ready!" and "MORE," each designed for different types of computer hardware.

John L. Friend is an independent computer program designer, doing business as "Softworks Development." Friend designed a new outlining program called "PC-Outline," a program he said was "inspired by" Symantec's ThinkTank program. Friend stated he "borrowed" several of ThinkTank's features for PC-Outline.

In April 1987, Friend sold PC-Outline to Brown Bag. As part of the purchase agreement, Friend warranted that he was not then developing a program that would infringe Brown Bag's newly acquired copyright in PC-Outline. In return, Brown Bag granted Friend a "non-exclusive right" to use 129 pages of computer source code.[1]

Also in 1987, Friend developed and sold an outlining program called "Grandview" to Symantec. Symantec marketed the new program as an updated version of its ThinkTank and MORE programs. Under the terms of the sale, Friend retained custody of Grandview's source code.[2]

On June 8, 1988, Brown Bag sued Symantec and Friend in federal district court. Brown Bag alleged that Symantec's

---

[1]"The list of commands written by the programmer is known as *source code* and is typically readable by those conversant in the programming language ("C," BASIC, PASCAL, FORTRAN, etc.). The source code is converted by a program known as a [compiler] into the binary zeros and ones — the *object code* or machine language — to be run by the computer." Wallace Walter, *It Does Not Compute*, Legal Times, June 17, 1991, (Supplement), at 50, 51-52.

[2]To the extent that property rights in the source code exist apart from other aspects of Grandview, ownership of the source code is unclear. Friend declared that while a copy of the code was delivered to Symantec, Symantec may only look at the code "under certain conditions of default under our agreement, none of which has occurred."

Grandview infringed Brown Bag's copyright and trademark rights in PC-Outline, in violation of federal law. Brown Bag also alleged several pendent state law claims.

At the beginning of the suit, outside counsel represented Brown Bag. Counsel for all parties stipulated to measures designed to protect Symantec's and Friend's trade secrets divulged in discovery. These trade secrets included the source code for Grandview, developmental plans for Grandview, and the identities of "beta testers," consumer representatives upon whom Symantec market-tested different versions of Grandview. The parties' stipulation restricted access to these materials to "attorneys' eyes only."

On February 17, 1989, Brown Bag's retained counsel withdrew, and Brown Bag's newly hired in-house counsel entered his appearance on behalf of Brown Bag. Symantec moved for a protective order restricting the access of Brown Bag's in-house counsel to the documents labelled "attorneys' eyes only" under the parties' previous stipulation.

On March 8, 1989, after an evidentiary hearing, a magistrate issued an order preventing Brown Bag's in-house counsel from directly viewing the documents. The order provided for Brown Bag's access only through an "independent consultant, legal or otherwise." Specifically, the protective order envisioned an outside consultant hired by Brown Bag who would review the "attorneys' eyes only" documents and advise Brown Bag regarding their relevance. As the magistrate stated at the hearing, "if [it] is the opinion of the outside consultant that in house counsel needs [certain] material in order to pursue the litigation, then there has to be a very specific request, item by item, back to the court for the items that are deemed to be necessary." The magistrate thus did not rule out the possibility of some disclosure of sensitive documents to Brown Bag's in-house counsel.

On April 4 and 5, 1989, Symantec and Friend moved for summary judgment. On April 24, 1989, the district court

denied Brown Bag's motion for reconsideration of the magistrate's protective order and for extension of the discovery period. On April 28, 1989, Symantec filed a motion to strike the two declarations Brown Bag had filed in opposition to summary judgment. The district court did not separately rule on these motions.

After the May 5 summary judgment hearing, the district court requested supplementary "letter briefs" from all parties. Symantec's counsel submitted its letter brief on May 11 on behalf of both Symantec and Friend. Brown Bag also submitted its letter brief on May 11. On May 19, Friend filed a "supplemental declaration in support of summary judgment."

On May 24, 1989, the district court granted summary judgment to Symantec and Friend. The court subsequently entered an "Amended Order" granting summary judgment to Symantec and Friend, and dismissing Brown Bag's state law claims. *Telemarketing Resources v. Symantec Corp.*, 12 U.S.P.Q.2d (BNA) 1991 (N.D. Cal. 1989). Brown Bag timely appeals the protective order and summary judgment.

DISCUSSION

I. *Access of Brown Bag's In-House Counsel to Trade Secrets Divulged in Discovery*

This court reviews a district court's rulings concerning discovery for an abuse of discretion. *Ah Moo v. A.G. Becker Paribas, Inc.*, 857 F.2d 615, 619 (9th Cir. 1988).

Rule 26(c) of the Federal Rules of Civil Procedure explicitly authorizes the district court to protect parties from "undue burden or expense" in discovery by ordering "that a trade secret or other confidential research, development, or commercial information not be disclosed or be disclosed only in a designated way." The parties agree that source codes, development plans, and beta tester information (all of which Sym-

antec produced to Brown Bag's retained outside counsel under protective stipulation) constitute protectable trade secrets under Rule 26(c). Brown Bag contests, however, the court order requiring Brown Bag to retain an "independent consultant" to view those trade secrets. Brown Bag contends that the court should have permitted its in-house counsel immediate and direct access to those trade secrets.

[1] We have not previously determined when protective orders for trade secrets may be appropriate. The issue entails conflicting interests. On the one hand, parties seeking discovery are entitled to all information "reasonably calculated to lead to the discovery of admissible evidence," Fed. R. Civ. P. 26(b)(1) — an intentionally broad mandate. On the other hand, responding parties are entitled to protection from "undue burden" in discovery, including protection from misuse of trade secrets by competitors. Fed. R. Civ. P. 26(c). These conflicting interests suggest that a balancing test will best resolve protective order disputes such as the one here. Specifically, in this case we must balance the risk to Symantec of inadvertent disclosure of trade secrets to competitors against the risk to Brown Bag that protection of Symantec's trade secrets impaired prosecution of Brown Bag's claims.

According to Brown Bag, preventing its in-house counsel from immediate and direct access to the trade secrets in question also prevents Brown Bag from exercising its due process rights to select counsel and to prosecute its claims. Brown Bag contends that the district court arbitrarily distinguished between outside counsel, whom the court permitted access to the trade secrets, and in-house counsel, whom it denied direct access under the protective order. Brown Bag argues further that the protective order resulted in Brown Bag's inability to oppose summary judgment adequately because in-house counsel's examination of the trade secrets might have produced evidence supporting Brown Bag's opposition.

We turn to *U.S. Steel Corp. v. United States*, 730 F.2d 1465 (Fed. Cir. 1984), as the leading authority on protective orders

distinguishing between outside and in-house counsel. *See also Matsushita Elec. Indus. Co. v. United States*, 929 F.2d 1577, 1579 (Fed. Cir. 1991) (applying *U.S. Steel* analysis). The *U.S. Steel* court cautioned against arbitrary distinctions based on type of counsel employed, noting that in practice the risk of inadvertent disclosure of trade secrets obtains equally for both kinds of counsel. 730 F.2d at 1468. The *U.S. Steel* court concluded that, to evaluate the risk of inadvertent disclosure, a court should examine the factual circumstances of *any* counsel's relationship to the party demanding access. *Id.* A crucial factor in the *U.S. Steel* case was whether in-house counsel was involved in "competitive decisionmaking"; that is, advising on decisions about pricing or design "made in light of similar or corresponding information about a competitor." *Id.* at 1468 n.3.

[2] Thus, proper review of protective orders in cases such as this requires the district court to examine factually all the risks and safeguards surrounding inadvertent disclosure by *any* counsel, whether in-house or retained. Further, the nature of the claims and of a party's opportunity to develop its case through alternative discovery procedures factors into decisions on the propriety of such protective orders. Brown Bag and amicus American Corporate Counsel Association contend that the magistrate failed to perform just such a factual inquiry before crafting the protective order in this case.

The record belies this contention. The magistrate in fact held a comprehensive evidentiary hearing prior to issuing the protective order. At the hearing, Symantec's counsel described the extreme sensitivity of the trade secrets at issue. Symantec's counsel further described the potential damage to Symantec should the trade secrets inadvertently become subject to misuse by Symantec's competitor, Brown Bag. Brown Bag's counsel did not dispute the dangers inadvertent disclosure posed to Symantec. Instead, Brown Bag's counsel reassured the magistrate that the professional integrity of in-house counsel and his promise to store the trade secret documents in

a locked file cabinet in his Brown Bag office sufficiently protected Symantec from inadvertent disclosure.

The magistrate expressly credited in-house counsel's integrity and good faith. The magistrate had to consider, however, not only whether the documents could be locked up in cabinets, but also whether Brown Bag's counsel could lock-up trade secrets in his mind, safe from inadvertent disclosure to his employer once he had read the documents. As the *U.S. Steel* court suggested, the magistrate therefore inquired into counsel's responsibilities as Brown Bag's sole legal advisor and personnel manager. Brown Bag's counsel stated that he was hired just a few weeks prior to the hearing, that he was one of thirteen or fourteen employees, and that he did not yet know the duties of fellow employees. Brown Bag's counsel agreed that he was responsible for advising his employer on a gamut of legal issues, including contracts, marketing, and employment.

[3] From this testimony, the magistrate reasonably concluded that Brown Bag's counsel's employment would necessarily entail advising his employer in areas relating to Symantec's trade secrets. Knowledge of Symantec's trade secrets would place in-house counsel in the "untenable position" of having to refuse his employer legal advice on a host of contract, employment, and competitive marketing decisions lest he improperly or indirectly reveal Symantec's trade secrets. For example, Brown Bag's counsel could not advise his employer on beta tester employment or other marketing strategies that might relate to information he had learned about Symantec's beta tester program or its development and promotion plans for Grandview. Brown Bag's in-house counsel was thus involved in the kind of "competitive decisionmaking" that counsels against disclosure under the *U.S. Steel* analysis.

[4] Further, the magistrate weighed not only the risk of disclosure to Symantec, but also the potential impairment of

Brown Bag's case against Symantec. The evidentiary hearing revealed that, before in-house counsel appeared for Brown Bag, Brown Bag's former outside counsel had already had over six months in which to study the trade secrets. Brown Bag knew of the court-ordered deadline for summary judgment motions, and had had ample time to develop any admissible evidence it could from the trade secrets divulged to it. Further, none of the trade secrets were themselves relevant to Brown Bag's "look and feel" infringement claim, a claim dependent on comparison of the two published programs. Pursuant to Federal Rule of Civil Procedure 26(b), Brown Bag's counsel argued at the hearing that review of the trade secrets might "lead to the discovery of admissible evidence." Speculation as to what Brown Bag might discover in the future, however, was irrelevant because the deadline for discovery had passed. And, in any event, the magistrate provided means by which Brown Bag's in-house counsel could have obtained access to essential documents. Thus, the magistrate adequately considered the hardship a protective order might impose on Brown Bag's prosecution of its claims.

In sum, the record reveals that the magistrate inquired into the specific factual circumstances of Symantec's and Brown Bag's conflicting interests. The resulting protective order strikes a reasonable balance between those interests by shielding Brown Bag's in-house counsel from personal knowledge of a competitor's trade secrets, but allowing access to information through an independent consultant. The order did not arbitrarily distinguish outside and in-house counsel. Rather, in reaching its decision, the court considered the particular circumstances of Brown Bag's counsel then before it. The same considerations could have applied equally to outside counsel.

[5] Finally, Brown Bag's assertion that the protective order unfairly hindered its opposition to summary judgment is too speculative to establish that the protective order was an abuse of discretion. We stress that Brown Bag failed to demonstrate how the protective order actually could have or did prejudice

its case. Brown Bag never attempted to implement the independent consultant method of access to the trade secrets and never argued the method was unduly burdensome. Instead, Brown Bag alleged its unfettered right to the discovery documents and complained of arbitrary discrimination against in-house counsel. Brown Bag's arguments are unsubstantiated. We therefore hold that the court did not abuse its discretion in issuing the protective order.

II. *Summary Judgment on Brown Bag's Copyright Infringement Claim*

Brown Bag refrains from contending that a disputed issue of fact precluded summary judgment on its copyright infringement claim. Instead, Brown Bag identifies several alleged errors of law it believes entitle it to reversal of summary judgment. We review the summary judgment de novo. *Narell v. Freeman*, 872 F.2d 907, 909 (9th Cir. 1989).

To establish a copyright infringement claim, Brown Bag must show that it owns a valid copyright in PC-Outline and that Symantec and Friend copied protected elements of the program. *Narell*, 872 F.2d at 910. Brown Bag's ownership of a valid copyright in PC-Outline is undisputed. To establish the copying element of the claim, Brown Bag intended to show that Symantec and Friend had access to PC-Outline and that relevant portions of Grandview are substantially similar to those portions of PC-Outline in which Brown Bag owns a copyright. *See id.* Because Symantec also concedes that access is not at issue, the defendant's motion for summary judgment focused on Brown Bag's allegations of substantial similarity.

[6] Summary judgment for a defendant accused of copyright infringement is appropriate when the plaintiff fails to show a genuine issue regarding whether the ideas and expressive elements of the works are substantially similar. *Frybarger v. International Business Machs. Corp.*, 812 F.2d

525, 528 (9th Cir. 1987). This is so because the plaintiff bears the burden of proving that the allegedly infringing work is substantially similar to the work protected by plaintiff's copyright. *Id.* A "genuine issue" exists when the plaintiff provides indicia of "a sufficient disagreement" concerning the substantial similarity of two works "to require submission to a jury." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 251-52 (1986); *see id.* at 248-52.

In response to the summary judgment motion brought by Friend and Symantec, Brown Bag submitted the declarations of its president, Sanford B. Schupper, and its computer expert, Ronald Ogg. The Ogg declaration set forth seventeen specific features in PC-Outline and Grandview alleged to be similar. *See Telemarketing Resources*, 12 U.S.P.Q.2d (BNA) at 1994-95. "[U]sing [Ogg's] list as a tool to organize the features which plaintiff asserts are substantially similar in the two programs," *id.* at 1994 n.3, the district court found that none of the listed features could form the basis for a finding of copyright infringement. *Id.* at 1995-96.

In particular, the district court ruled that one group of features represented a claim of copyright in "concepts . . . fundamental to a host of computer programs" such as "the need to access existing files, edit the work, and print the work." *Id.* at 1995. As such, these features, which took the form of four options in the programs' opening menus, were held to be unprotectable under copyright. *Id.*

A second group of features involved "nine functions listed in the menu bar" and the fact that "virtually all of the functions of the PC-Outline program[ ] can be performed by Grandview." *Id.* The district court declared that "these functions constitute the idea of the outlining program" and, furthermore, "[t]he expression of the ideas inherent in the features are . . . distinct." *Id.* The court also held that "the similarity of using the main editing screen to enter and edit data

. . . . is essential to the very idea of a computer outlining program." *Id.*

The third group of features common to PC-Outline and Grandview concerned "the use of pull down windows." *Id.* Regarding these features, the district court made three separate rulings. The court first found that "[p]laintiffs may not claim copyright protection of an . . . expression that is, if not standard, then commonplace in the computer software industry." *Id.* Second, the district court ruled that defendants had rebutted the presumption of originality attaching to Brown Bag's registered copyright in PC-Outline's use of pull-down windows, so that there was no copyright in this feature. *Id.* The court supported this finding with Friend's admission that he had based PC-Outline on ThinkTank. *Id.* Finally, the court concluded that the pull-down windows of the two programs look different. *Id.*

Regarding the color schemes of the two programs, the lower court noted that "[p]laintiff admits that fewer than 10 of the 44 default color selections in the [G]randview program are the same as the default color selections in the PC-Outline program." The court also rejected the similar blue backgrounds as a basis for finding infringement, citing functionality, a rule of the Copyright Office, and a decision of this court. *Id.* at 1995-96.

Regarding a fifth group of features, the district court concluded that any resemblance here was the permissible result of Friend's exercise of his rights under the license granted by Brown Bag as part of Friend's sale of PC-Outline to Brown Bag. *Id.* at 1996.

With regard to these five groups of features, the district court concluded that "many of the expressions which plaintiff argues are substantially similar are either not protected under the copyright or were licensed to Mr. Friend." *Id.* Thus, the

court ruled, "[p]laintiff may not rely on these features in proving its case at trial." *Id.*

Finally, regarding the two screens presenting the programs' respective opening menus, the court ruled that "the expression[s] of the two screens are not substantially similar, as a matter of law." *Id.* Finding that "[p]laintiff has failed to meet its evidentiary burden on this matter," the district court granted Symantec's summary judgment motion. *Id.*

Brown Bag attacks the district court's decision on four grounds. First, Brown Bag asserts that the district court wrongly rejected two affidavits it submitted in opposing summary judgment. Second, Brown Bag argues that Friend's supplemental declaration supporting summary judgment should not have been considered. Next, the plaintiff contends the district court erred in holding that Symantec had rebutted the presumption of originality adhering in the use of pull-down windows in PC-Outline. Finally, Brown Bag challenges the legal analysis used by the lower court to determine that no genuine issue existed regarding substantial similarity between the two programs. We reject each of these contentions.

A. *Refusal to Consider Brown Bag's Affidavits*

Symantec objected to Brown Bag's submission of Ronald Ogg's affidavit in opposition to summary judgment because Brown Bag had not disclosed Ogg as an expert witness in response to interrogatories. Brown Bag argues that the district court should have considered Ogg's expert opinion. The district court did use the list of program features contained in Ogg's affidavit to perform its analytic dissection. 12 U.S.P.Q.2d (BNA) at 1994 n.3. The court did not, however, consider Ogg's opinion itself. *Id.*

[7] In this court's leading copyright infringement case, we held that, in assessing the similarity of two works, expert testimony is appropriate in some respects and inappropriate in

others. *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977). Initially, the line was drawn between comparing ideas embodied in a work, for which expert testimony was appropriate, and comparing the works' respective expressions of common ideas, for which expert testimony was thought inappropriate. *Id.* Recently, however, we have recognized that the line is more properly drawn between objective and subjective analyses of expression. *Shaw v. Lindheim*, 919 F.2d 1353, 1357 (9th Cir. 1990). As such, expert opinion is relevant not only to the analysis of ideas behind two works but also to the objective analysis of expression. *See id.*[3]

[8] Here, the district court relied on the disputed Ogg affidavit to identify objective components for comparison. The district court therefore considered the declaration of Brown Bag's expert to the full extent permitted under our circuit's law. Furthermore, Brown Bag failed to establish that the district court's decision not to credit Ogg's opinion more fully prejudiced Brown Bag.

Brown Bag also contends that the district court rejected the declaration of Sanford B. Schupper, Brown Bag's president. Symantec and Friend objected to the admission of exhibits of newspaper articles attached to Schupper's declaration. The district court did not rule on Symantec's and Friend's objection. Neither did it reference Schupper's declaration or the exhibits in its order granting summary judgment. On this record, Brown Bag can point to no rejection or denial of the affidavit to appeal. Even if the district court somehow erred in failing to consider Schupper's declaration, moreover, such error was harmless. Brown Bag has not argued how consideration of Schupper's declaration would have changed the result reached by the district court.

[3]Ninth Circuit law thus appears to be moving toward the test favored by Judge Sneed in his separate concurrence in which lay and expert testimony are uniformily admissible.

B. *Consideration of Friend's Supplemental Declaration*

Brown Bag contends that the district court relied on Friend's supplemental declaration in determining that various features common to both PC-Outline and Grandview were not protected by Brown Bag's copyright. Friend submitted the declaration after the summary judgment hearing and eight days after the district court's deadline for supplementary "letter briefs." Friend had previously joined Symantec's letter brief. Brown Bag argues that the untimeliness of Friend's declaration and the district court's reliance on it deprived Brown Bag of its due process right to respond.

We review a district court's evidentiary rulings for an abuse of discretion. *Roberts v. College of the Desert*, 870 F.2d 1411, 1418 (9th Cir. 1988). Reversal requires a showing of prejudice. *Id.* The district court here did not abuse its discretion by considering the Friend declaration. Brown Bag did not object to the declaration before the district court, nor has it argued on appeal that the declaration was inaccurate. If the declaration prejudiced Brown Bag, Brown Bag should have asserted that concern to the district court.

C. *Rebuttal of Presumption of Originality*

[9] Brown Bag was entitled to a presumption of originality in its PC-Outline copyright because the copyright was registered. *See Johnson Controls v. Phoenix Control Systems*, 886 F.2d 1173, 1175 (9th Cir. 1989). The district court held that Symantec and Friend rebutted this presumption of originality in PC-Outline's pull-down menus by showing that ThinkTank and other Symantec programs used pull-down menus prior to the development of PC-Outline. Brown Bag argues that, under the *Johnson Controls* case, the district court erred in this holding.

[10] Brown Bag's argument is meritless because the *Johnson Controls* case upon which Brown Bag relies does not

apply here. In *Johnson Controls*, defendant contended that plaintiff's copyrighted program was not original because "there are similar programs in use by other companies." 886 F.2d at 1175. We held that this assertion "is insufficient to rebut the presumption [of originality] in the absence of any evidence that [the plaintiff] copied from these other programs." *Id.*

In contrast, here Friend specifically stated that ThinkTank inspired his design of both PC-Outline and Grandview. The district court therefore had evidence from which it could reasonably infer that Friend copied the use of pull-down menus from ThinkTank. In any event, the district court provided two alternative grounds on which it denied copyright protection to Brown Bag's use of pull-down menus. The plaintiff challenges neither of these alternatives on appeal.

D. *Legal Analysis of Substantial Similarity*

In the *Krofft* case, we established a two-part test for substantial similarity. 562 F.2d at 1164. Under the original formulation of *Krofft*'s "extrinsic" component, a plaintiff needed to prove only the "similarity of ideas" in the two programs. *Id.* Today, however, the extrinsic test looks at more than just the similarity of ideas. As the district court understood, the extrinsic analysis is " 'an objective test which rests upon specific criteria that can be listed and analyzed.' " 12 U.S.P.Q.2d at 1994 (quoting *Data East USA, Inc. v. Epyx, Inc.*, 862 F.2d 204, 208 (9th Cir. 1988)). The extrinsic test thus has become an "objective . . . analys[is] of *expression*." *Shaw*, 919 F.2d at 1357 (original emphasis); *see also* 3 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 13.03[E][3], at 13-78.19 to -78.20 (1991) (hereinafter, "Nimmer") (discussing reformulation of *Krofft* analysis achieved in *Shaw*).

To establish infringement of a copyright, the two works in question must also meet the second component of the test set forth in *Krofft*, the "intrinsic test." 562 F.2d at 1164. The

intrinsic test, according to *Krofft*, should measure "substantial similarity in expressions . . . depending on the response of the ordinary reasonable person. . . .[I]t does not depend on the type of external criteria and analysis which marks the extrinsic test." *Id.* (citations omitted). In applying the intrinsic test, therefore, "analytic dissection and expert testimony are not appropriate." *Id.*

Brown Bag contends that the district court misapplied the intrinsic test because the court improperly performed "analytic dissection" in comparing the expressions of ideas embodied in the two programs. Indeed, the district court explicitly performed "analytic dissection," comparing specific screens, menus, and keystrokes, in part to detect substantial similarity. 12 U.S.P.Q.2d (BNA) at 1995-96. The court performed the dissection at Brown Bag's behest and in response to a list of allegedly substantially similar features Brown Bag proffered in opposition to summary judgment.

[11] Brown Bag's argument ignores the evolution of the "extrinsic" component of the *Krofft* analysis. Properly understood, the district court's analysis was not a misapplication of the "intrinsic test," but a proper application of the revised "extrinsic test." Under the reformulated extrinsic test, we mean to perpetuate "analytic dissection" as a tool for comparing not only ideas but also expression. Thus, it was not error for the district court to use "analytic dissection" in comparing the expressions of the two programs. Specifically, the district court properly compared the expressions embodied in the two screens presenting the programs' respective opening menus. *See* 12 U.S.P.Q.2d (BNA) at 1996.

[12] The district court's analytic dissection of the five groups of features involving unprotected or unprotectable work was also proper, but for an entirely diffe nt reason. This analysis had nothing to do with assessing substantial similarity, and therefore was not subject to the old limitations *Krofft* imposed on the use of analytic dissection. Instead, as

to these groups, the district court applied analytic dissection for the purpose of determining "whether similarities [between the programs] result from unprotectable [or unprotected] expression." *Data East*, 862 F.2d at 208. In this application, analytic dissection is used not for the purposes of comparing similarities and identifying infringement, but for the purpose of defining the scope of plaintiff's copyright.

This point bears emphasis. Analytic dissection is relevant not only to the copying element of a copyright infringement claim, but also to the claim's ownership element. One aspect of the ownership element is the copyrightability of the subject matter and, more particularly, the scope of whatever copyright lies therein. *See* Nimmer § 13.01[A]. To the extent a plaintiff's work is unprotected or unprotectable under copyright, the scope of the copyright must be limited. *See, e.g., Data East*, 862 F.2d at 209 (holding that, because "the similarities result from unprotectable expression," "[t]he lower court erred by not limiting the scope of [plaintiff's] copyright protection").[4] Thus, where two works are found to be similar without regard to the scope of the copyright in the plaintiff's work, *Data East* teaches that the source of the similarity must be identified and a determination made as to whether this source is covered by plaintiff's copyright. It is this process in which the district court engaged with regard to the five groups of features found to be unprotected or unprotectable by Brown Bag's copyright in PC-Outline. Again, this use of analytic dissection was proper.

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[4]The degree to which unprotected or unprotectable features must be eliminated from a comparison of two works is difficult to say. Although copyright protection is not afforded to certain elements of a work, such limitations "must not obscure the general proposition that copyright may inhere, under appropriate circumstances, in the selection and arrangement of unprotected components." Nimmer § 13.03[F][5], at 13-78.44 n.342; *accord Feist Publications, Inc. v. Rural Telephone Serv. Co.*, 111 S. Ct. 1282, 1289, 1294 (1991); *see* Nimmer § 13.03[F][5], at 13-78.45 n.345 (discussing Ninth Circuit cases).

Brown Bag further argues that the district court became so engrossed in its analytic dissection that it neglected to evaluate the "overall look and feel" of the two programs for substantial similarity. Stated differently, Brown Bag contends that the district court failed to consider the "intrinsic" component of the *Krofft* test, which involves a subjective analysis of similarities in expression. *See Shaw*, 919 F.2d at 1357. Even assuming this is true, we find no reversible error because the record fails to include any evidence indicating that Brown Bag requested the district court to make this analysis. Although the district court "entertained an in-court demonstration of the two programs and . . . carefully reviewed submitted copies of relevant outlining programs," 12 U.S.P.Q.2d (BNA) at 1992, no such evidence was ever included as part of Brown Bag's opposition to Symantec's summary judgment motion. Therefore, there is no reason we should expect the district court to have made the analysis Brown Bag now requests.

Finally, Brown Bag argues that, because PC-Outline and Grandview shared a common idea — specifically the idea of an outlining program — summary judgment is precluded by our decision in *Shaw*. We held in *Shaw* that "satisfaction of the extrinsic test creates a triable issue of fact in a copyright action involving a literary work." 919 F.2d at 1359.

In response, Symantec argues we should distinguish *Shaw* from the instant case on the basis that the *Shaw* rule applies by its own terms only to literary works. We decline to distinguish *Shaw* for that reason, however, because at least some computer programs bear significant similarities to literary works. On the scant record available to us in this case, we cannot conclude as a matter of law that the programs at issue here, or computer programs in general, are so nonliterary or so limited in their variety of expression as to avoid application of the rule announced in *Shaw*.

We nevertheless reject Brown Bag's argument on the basis that it misapprehends the nature of the "extrinsic" test follow-

ing *Shaw*. If the rule in *Shaw* was applied without recognizing that the extrinsic test now includes some analysis of expression, *Shaw* would ring "the death-knell in the Ninth Circuit for defense summary judgments based on purported absence of substantial similarity." Nimmer § 13.03[E][3], at 13-78.20. But, as we have discussed, after *Shaw* the extrinsic test examines not only similarity of ideas, but also objective similarity of expressions.

[13] In particular, the extrinsic test for literary works requires analytic dissection of several "objective components of expression," *Shaw*, 919 F.2d at 1361, within a literary work such as plot, theme, characters, and dialogue. *Id.* at 1356-57. Similarity of these objective components in two literary works logically gives rise to a triable issue of similarity. *Id.* at 1357. Likewise, computer programs are subject to a *Shawtype analytic dissection of various standard components, e.g.*, screens, menus, and keystrokes. Because the district court found that Brown Bag made no showing of similarity along these lines with regard to copyrighted components of PC-Outline, summary judgment was not precluded by the rule announced in *Shaw*. *See also* Nimmer § 13.03[E][3], at 13-78.20 ("given *Shaw*'s reformulation of the extrinsic test, the decision is better viewed as standing for the unremarkable proposition that when objectively speaking a triable case of expressive similarity exists, the case must be sent to the trier of fact; but when no such objective argument is possible, summary judgment will lie.") (footnotes omitted).[5]

III. *Brown Bag's Federal Trademark/Trade Dress Claim*

In its complaint, Brown Bag alleged two federal claims, copyright infringement and "false designation of origin," a

[5]The federal copyright act authorizes the award of attorney's fees and costs to the prevailing party. 17 U.S.C. § 505. Anticipating reversal of summary judgment, Brown Bag requests its fees and costs. We deny the request.

violation of section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a). For its Lanham Act claim, Brown Bag alleges that "Defendants ... falsely promote Grandview as being an upgrade, derivative or improvement upon PC-Outline in a manner to suggest a connection with [Brown Bag] .... There is a likelihood of confusion, mistake or deception."[6] [Complaint at 9, ER at F.]

[14] The district court dismissed Brown Bag's pendent state claims because it had granted summary judgment to Symantec and Friend on Brown Bag's federal claims. The district court's order granting summary judgment does not even mention the Lanham Act claim, however. If the district court intended to grant summary judgment on the Lanham Act claim as well, its order granting summary judgment on the infringement claim presents no rationale for it. On this record, it appears that the district court intended to dispose of all federal claims on summary judgment, but overlooked the Lanham Act claim.

Symantec argues that we should infer the district court intended to grant summary judgment on the Lanham Act claim and affirm that judgment on the basis of the record. In support of its motion for summary judgment, Symantec informed the district court that there was "no evidence that Symantec or its agents falsely promoted Grandview ... in [a]

[6]The claim which Brown Bag alleges is a Lanham Act false designation of origin claim, distinguishable from a "reverse passing off" claim. In a "reverse passing off" claim under the Lanham Act, a defendant markets a copied product as its own. *See Shaw*, 919 F.2d at 1364. A reverse passing off claim is therefore dependent upon a successful infringement claim. *Id.* (declining to recognize reverse passing off claims in all events). Because Brown Bag alleged in its complaint a false designation of origin claim, however, Brown Bag need not have shown that Symantec and Friend infringed Brown Bag's copyright in PC-Outline in order to state a claim under the Lanham Act that Symantec and Friend falsely promoted Grandview as an updated version of PC-Outline. Summary judgment on Brown Bag's copyright infringement claim, therefore, did not compel summary judgment on its Lanham Act claim.

manner as to suggest a connection with [Brown Bag]." In response, Brown Bag failed to offer any evidence pertaining to the Lanham Act claim, and therefore failed to carry its evidentiary burden in opposing summary judgment. *See* Fed. R. Civ. P. 56(c); *Shaw*, 919 F.2d at 1359. Because the evidence of record is one-sided in favor of Symantec, Symantec argues that we should infer and affirm the district court's summary judgment for Symantec on the Lanham Act claim.

[15] Symantec's argument is pragmatic, assuring as it would a final end to the litigation given that Brown Bag's other claims of error are without merit. Symantec asks this court, however, to infer a district court's decision on an entire claim and to rewrite a district court judgment to include the inferred decision. We decline to take such liberties with a district court's intentions and judgments. Instead, we conclude that it was Symantec's and Friend's responsibility to clarify the district court's judgment and to save themselves needless litigation over a possible oversight. We therefore remand the Lanham Act claim for such clarification and for further proceedings as the district court deems necessary in light of our opinion.

IV. *Friend's Notice of Joinder in Symantec's Appellate Brief*

Symantec's and Friend's appellate briefs were due in this court July 25, 1990. Symantec submitted its brief on that date. On July 30, 1990, Friend filed a "Notice of Joinder in Brief of Appellee Symantec." Brown Bag moved this court to strike Friend's notice as untimely and to reverse summary judgment as to Friend for his failure to oppose the appeal. Brown Bag cited no authority for its requested action. Neither Friend nor Symantec responded to Brown Bag's motion.

The only sanction authorized by the Federal Rules of Appellate Procedure for an appellee's failure to file a timely brief is refusal to hear the appellee at oral argument. Fed. R.

App. P. 31(c). The limited nature of this sanction coincides with our duty to affirm the judgment on any ground fairly supported by the record. *See Wabol v. Villacrusis*, 908 F.2d 411, 424 n.22 (9th Cir. 1990); *United States v. Bergmann*, 836 F.2d 1220, 1223 (9th Cir. 1988). Because Brown Bag appealed the judgment for Friend, and because the record supports judgment for Friend even in the absence of his joinder or briefing, we affirm judgment for Friend as well as for Symantec. We therefore perceive no prejudice to Brown Bag in permitting Friend's joinder, although we by no means condone untimely filings. Accordingly, the motion to strike is denied.

CONCLUSION

The protective order limiting Brown Bag's access to Symantec's trade secrets struck a reasonable balance between the parties' interests. We affirm that order as a proper exercise of discretion. The record fails to support Brown Bag's objections to summary judgment on its copyright infringement claim. We therefore affirm that judgment for both Symantec and Friend. The record does not support an inference that the district court granted summary judgment on the Lanham Act claim, however. We therefore remand that claim for further proceedings consistent with this opinion.

The judgment of the district court is AFFIRMED-IN-PART and VACATED-IN-PART, and the case is REMANDED.

SNEED, Senior Circuit Judge, Concurring Separately:

I concur in Parts I and III of Judge Tang's opinion, and in the judgment with respect to Part II.

My difference as to Part II is rooted in my belief that *Shaw v. Lindheim*, 919 F.2d 1353 (9th Cir. 1990), provides a poor

analytic structure by which to determine the substantial similarity of an allegedly infringing computer program. This is a message already dispatched by District Judge Orrick of the Northern District of California in *Broderbund Software Inc. v. Unison World Inc.*, 648 F. Supp. 1127, 1136 (1986). He preferred Circuit Judge Becker's approach in *Whelan Associates, Inc. v. Jaslow Dental Laboratory, Inc.*, 797 F.2d 1222 (3d Cir. 1986), *cert. denied*, 479 U.S. 1031 (1987). That approach was described by Judge Orrick as "an integrated substantial similarity test pursuant to which both lay and expert testimony would be admissible." *Broderbund*, 648 F. Supp. at 1136.

I remain convinced, however, that even were we to travel the road pointed to by Judge Orrick, we would end up precisely where we now are. The trip would be unnecessary; therefore, I concur in the result reached in Part II.

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APPENDIX B

Final Judgment, United States District Court for the Northern District of California (San Jose) [Telemarketing Resources, Inc. V. Symantec Corp. and John L. Friend, an individual dba Softworks Development, 12 U.S.P.Q. 2d (BNA) 1991 (N.D. Cal. 1989)]

DISTRICT COURT, N.D. CALIFORNIA

Telemarketing Resources v. Symantec Corp.

No. C 88-20352 RPA

Decided September 6, 1989

COPYRIGHTS

1. NON-COPYRIGHTABLE MATTER - IDEAS AND SYSTEMS (§ 211.05)

PROTECTABILITY OF COMPUTER PRODUCTS - IN GENERAL (§ 225.01)

Use of opening "menu" in computer program is idea and thus not protectable.

2. NON-COPYRIGHTABLE MATTER - IDEAS AND SYSTEMS (§ 211.05)

PROTECTABILITY OF COMPUTER PRODUCTS - IN GENERAL (§ 225.01)

Functions in computer software program to facilitate creation and editing of outlines, such as opening or starting new outline, accessing existing outline, accessing directory, and quitting program altogether, are inherent in idea of outlining program and are not protected under copyright.

3. RIGHTS IN COPYRIGHT; INFRINGEMENT -RIGHT TO REPRODUCTION IN COPIES OR PHONORECORDS - ACCESS, COPYING AND SUBSTANTIAL SIMILARITY (§213.0503)

PROTECTABILITY OF COMPUTER PRODUCTS - INFRINGEMENT (§ 225.07)

Accused opening screen, for computer software program to facilitate creation and

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editing of outlines, shares similar ideas with plaintiff's opening screen but is not substantially similar.

Action by Telemarketing Resources against Symantec Corp., and John L. Friend, d/b/a Softworks Development, for copyright infringement. On defendants' motion for summary judgment. Motion granted.

Limbach, Limbach & Sutton, San Francisco; Brian Flynn, Campbell, Calif., for plaintiff.

William F. Abrams and Paul Warner, of Jeffer, Mangels & Butler, San Francisco; Fenwick, Davis & West, Palo Alto, Calif., for defendants. AGUILAR, J.

AMENDED ORDER GRANTING
SUMMARY JUDGMENT MOTION

I.

The Court is called upon to decide whether the "look and feel" of the screen displays in defendants' computer outlining program are substantially dissimilar from plaintiff's copyrighted program so as to justify a grant of summary judgment. Towards this end, the Court must decide which elements of the computer program are ideas and which are protected expressions.

In addition to the briefs and supplemental papers filed on the summary judgment motion, the Court entertained an in-court demonstration of the two programs and has carefully reviewed submitted copies of relevant outlining programs. Good cause appearing therefor, the Court HEREBY GRANTS the motion for summary judgment for the reasons set out below.

II. FACTUAL BACKGROUND

A. Computer Outlining Programs

In 1983, Living Videotext, now a division of defendant Symantec, developed one of the premier computer outlining programs - "ThinkTank." Like most computer adaptions of everyday tasks, a computer outliner allows a user to create, revise, expand and reorganize an outline more quickly than can be done on paper. The program has two components - the computer code and the resulting displays on the computer screen.

Since 1983, Symantec has published several enhanced versions of ThinkTank and a series of increasingly more powerful outlining programs - "Ready!", "More" and "Grandview." The ThinkTank program was designed to run on IBM compatible computers. The user interface features included menus listing available commands and options, the ability to use function keys to perform tasks, and to translate regular keys to function keys when in a special mode.

The "More" program was developed for Apple's Macintosh computer. The program contained many of the distinc-

tive graphical interface features associated with Apple computer programs, and included pull down menus and both overlapping and tiled windows. Defendants argue that menu names coined for MORE were later included in Grandview.

"Grandview" is the latest computer outlining program offered by Symantec and was developed by defendant John L. Friend. Friend's first computer outlining program was PC-Outline, which he states was inspired by ThinkTank. Friend, doing business as Softworks, sold PC-Outline to plaintiff, Brown Bag Software. Because at the time of the sale, Friend was already working on the program which became Grandview, the Purchase and Sale Agreement contained the following clause:

> Software warrants and represents that it is not currently developing any computer program which would infringe the copyright rights to be assigned to TRI pursuant to this Agreement.

In addition, Friend was granted the right to use "the non-application- specific libraries and routines set forth in Exhibit C." Exhibit C consists of 129 pages of source code. Defendant Friend argues that the features of Grandview which plaintiff contends infringe the PC-Outline copyright were assigned to Friend pursuant to the Purchase and Sale Agreement. The assigned source code draws a menu bar at the top of the screen, draws the bar with one of the options highlighted, which can then be pulled down into a menu. Other routines draw the single line border around the menus

and windows as well as drawing the message line at the bottom of the screen.

When Symantec bought Friend's program, it required extensive reprogramming and format changes, allegedly to bring the new program into line with More and ThinkTank. The goal was to make Grandview appealable to users of More and ThinkTank.

Plaintiffs allege that Grandview is substantially similar to PC-Outline and actually an infringing derivative work of the copy-

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righted program. Defendants contend that the alleged infringing features are unprotected ideas, not expressions.

III. LEGAL STANDARDS

A. Summary Judgment

The Court must review the copyright claims, in light of the summary judgment attack, to determine whether plaintiffs have come forward "with specific facts showing that there is a genuine issue of material fact" to support the allegations of the complaint as to the defendants. Fed.R.Civ.P. 56(c); Matsushita Electrical Industrial Co. v. Zenith Radio, et al., 475 U.S. 574, 587, 106 S.Ct. 1348, 1356 (1986); Celotex v. Catrett, 477 U.S. 317, 106 S.Ct. 2548 (1986). There is no issue for trial unless there is sufficient evidence favoring the plaintiffs for a jury to return a verdict

for them. Anderson v. Liberty Lobby, 477 U.S. 242, 106 S.Ct. 2505, 2516 (1986). "A party opposing a properly supported motion for summary judgment may not rest upon mere allegation or denials of his pleading, but must set forth specific facts showing that there is a genuine issue for trial, supported by evidentiary material beyond the pleadings. Celotex, 477 U.S. at 324. "If the evidence is merely colorable, or is not significantly probative, summary judgment may be granted." Anderson, 477 U.S. at 249-250 (cites omitted). Plaintiff must meet his burden of proof in rebutting the summary judgment motion.

"Because plaintiff bears the burden of proving that the works are substantially similar in a copyright infringement case, summary judgment for defendant is appropriate when plaintiff fails to make a sufficient showing that the ideas and expressive elements of the works are substantially similar" Frybarger v. IBM Corp., 812 F.2d 525, 528 [2 USPQ2d 1135, 1137] (9th Cir. 1987).

B. Copyright Protection And Computer Programs

Copyright protection applies to the user interface, or overall structure and organization of a computer program, including its audiovisual displays, or screen "look and feel." Whelan Associates, Inc. v. Jaslow Dental Laboratory, Inc. 797 F.2d 1222, 1234 [230 USPQ 481, 488-89] (3d Cir. 1986); Broderbund Software v. Unison World, 648 F.Supp. 1127 [231 USPQ 700] (N.D. Cal. 1986).[1] In this case, defendants do not contest the copyrightability of computer screens in general, but argue that the functions which plaintiffs point to

as evidence of copying are ideas and hence not protected. In addition, John L. Friend asserts his license to use the source code which generates the alleged similarities.

To prevail on a claim for copyright infringement, plaintiff must prove ownership of the copyright and copying by the defendant. Copying by the defendant, in turn, may be shown by circumstantial evidence of access to the copyrighted work and substantial similarity between the copyrighted work, PC-Outline, and the allegedly infringing work, Grandview. Sid & Marty Krofft Television v. McDonald's Corp., 562 F.2d 1157, 1162 [196 USPQ 97, 101] (9th Cir. 1977); Baxter v. MCA, Inc., 812 F.2d 421, 423 [2 USPQ2d 1059, 1061] (9th Cir. 1987), cert. denied, _____U.S._____, 108 S.Ct. 346 (1987). In this case, there is no dispute over the copyright ownership or access to PC-Outline. The only disputed issue is whether or not there is substantial similarity in the expression of the idea of a computer outlining program.

However, the classic distinction between an idea and an expression serves to limit the scope of a copyright. "No one infringes, unless he descends so far into what is concrete as

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[1] *Computer generated screens for video games were found copyrightable as audiovisual works in Kramer Mfg. Co. v. Andrews, 783 F.2d 421 [228 USPQ 705] (4th Cir. 1986) and Williams Electronics v. Artic International, 685 F.2d 870 [215 USPQ 654] (3rd Cir. 1982). Digital Communications v. Softklone Dist., 659 F.Supp. 449 [2 USPQ2d 1385] (N.D. Ga. 1987) decided that a status screen for a computer program was subject to copyright protection as a compilation.*

to invade ... [its] expression." Sid and Marty Krofft, 562 F.2d at 1163 [196 USPQ at 101], citing National Comic Publications v. Fawcett Publications, 191 F.2d 594, 600 [90 USPQ 274, 278] (2d Cir. 1951); See also Baker v. Selden, 101 U.S. 99, 103 (1879). In addition, the courts have developed what is known as the merger doctrine, if an idea is indistinguishable or inseparable from, or limited by, its expression, "copying the expression will not be barred." Herbert Rosenthal Jewelry v. Kalpakian, 446 F.2d 738, 742 [170 USPQ 557, 559-60] (9th Cir. 1971); Data East v. Epyx, 862 F.2d at 208 [9 USPQ2d 1322 at 1325-26]; Aliotti v. R. Dakin & Co., 831 F.2d 898 [4 USPQ2d 1869] (9th Cir. 1987); NEC Corp. v. Intel Corp., 10 USPQ2d 1177, 1179 (N.D. Cal.

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1989). See also Morrisey v. Procter & Gamble Co., 379 F.2d 675 [154 USPQ 193] (1st Cir. 1967).[2]

Furthermore, if the underlying idea is subject to a limited range of expression, copyright protection would apply only "against virtually identical copying." Frybarger v. IBM, 812 F.2d at 530 [2 USPQ2d at 1138-39]; NEC v. Intel, 10 USPQ2d at 1188.

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[2]*In NEC v. Intel, Judge Grey held that the issue of merger and the relationship between idea and expression applies to the issue of infringement rather than copyrightability.*

Finally, copyright protection is not "afforded to elements of expression that necessarily follow from an idea" and are "'as a practical matter, indispensable or at least standard in the treatment of a given [idea].'" Data East v. Epyx, 862 F.2d at 208 [9 USPQ2d at 1325-26] (quoting Alioti, 831 F.2d at 901 [4 USPQ2d at 1871]).

Substantial similarity is established by first applying an "extrinsic" test to determine whether two ideas are similar. "This is an objective test which rests upon specific criteria that can be listed and analyzed." Data East v. Epyx, 862 F.2d at 208 [9 USPQ2d at 1325]; Sid & Marty Krofft, 562 F.2d at 1164 [196 USPQ at 102-03]. If the ideas are similar, the expression of the idea is compared under an intrinsic, subjective test "which depends on the response of the ordinary reasonable person." Data East, 862 F.2d at 208 [9 USPQ2d at 1325]; Sid & Marty Krofft, 562 F.2d at 1164 [196 USPQ at 102-03].

IV. A COMPARISON OF THE TWO PROGRAMS

The idea of a computer run outlining program is undisputedly identical in both Grandview and PC-Outline. However, defendants also describe many of the features which plaintiff seeks to protect as ideas inherent within a computer outlining program.

Plaintiff asserts that the following aspects of Grandview's user interface are substantially similar to PC- Outline. These similarities allegedly render the total look and feel of the two programs substantially similar.[3]

a. Both present an opening menu labeled "OPENING MENU."

b. Both opening menus are enclosed in a single line box and appear in contrasting color to the rest of the title screen.

c. A reverse video cursor o highlighting bar" appears over the options on both menus. The user moves the highlighting bar with the cursor arrows and presses the enter key to select an option.

d. In both programs, as an alternative to using the highlighting bar, the user can select any option by hitting the capitalized letter for that option.

e. Both opening menus have the same four options, although Grandview adds three more.

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[3]*The list of alleged similarities is drawn from the declaration of Mr. Ronald Ogg and plaintiff's memorandum of points and authorities. Defendants object to the submission of Mr. Ogg's declaration. Mr. Ogg's declaration, which contains expert opinion as to the similarity of the two programs, will not be considered by the Court. Nevertheless, the Court is using the list as a tool to organize the features which plaintiff asserts are substantially similar in the two programs. In any event, the programs themselves supersede and control any contrary opinion, allegations or descriptions submitted by the parties. See Nimmer on Copyright, 12-73 § 12.10; Decorative Aides Corp. v. Staple Sewing Aides Corp., 497 F.Supp. 154 [218 USPQ 657] (S.D.N.Y. 1980).*

f. Both programs permit a new outline to be begun from the opening menu. The user must enter a filename for the new outline and the program then displays a main editing screen.

g. Both programs permit the selection of an existing outline. The outline list is pulled down and the user selects an outline with the arrow and enter keys.

h. Both editing screens have file, cursor location and window information across the top of the screen. Both use pull down menus, and display a list of the available menus on a "menu bar" across the top of the screen. A help line is on the bottom of the screen. Both programs have a line around the screen. Plaintiffs also assert similarities in the color scheme of the programs.

i. The main editing screens are used to edit and enter new data in both programs.

j. A new outline element is entered by pressing the enter key while holding down the control key in both programs. The new element may be dragged around if no text is added.

k. Pull down menus are selected by first pressing a "menu attention" key. (In Grandview, the default menu attention key is the f10 key, in PC-Outline either the insert or "/" key is used as the menu attention key.)

l. Once the menu attention key is pressed, the initial letter of each of the menus is highlighted. The word MENU is also displayed at the right end of the menu bar.

m. A menu is selected by either pressing the highlighted initial letter for the desired menu, or moving the cursor across the screen to the desired menu. The menu is displayed in reverse video in a pull down window.

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n. The form of the menu window is the same in both programs, inasmuch as it is surrounded by a single line border with a reverse video highlighting bar which is moved up and down with the arrow keys. A highlighted option is selected by pressing the enter key. Alternatively, a user can select an option by typing the appropriate code letter, usually the first letter of the option. The codes are displayed at the left of the menu as single, uppercase letters.

o. In both programs, certain of the commands displayed on the pull down menus may be directly selected from the main editing screen through the use of special combinations of keys.

p. Both programs offer nine pull down menus. Of those nine, four of the menu description words are identical, the other five are different, but the functions are the same or similar.

q. Finally, plaintiffs note that "virtually every function performed by PC-Outline is also performed by Grandview."

"Analytic dissection" of plaintiff's alleged similarities may be performed to determine if the similarities result from unprotectable expression. Data East, 862 F.2d at 208 [9

USPQ2d at 1325]; Aliotti v. R. Dakin, 831 F.2d at 900-901 [4 USPQ2d at 1871].

Inherent in the idea of an outlining program is the need to access existing files, edit the work, and print the work. These concepts are fundamental to a host of computer programs. Nevertheless, plaintiffs assert that the presence of these four options in the menu screen demonstrates substantial similarity of expression. This expression is unprotectable.

Plaintiff similarly asserts that the nine functions listed in the menu bar, and virtually all of the functions of the PC-Outline program, can be performed by Grandview, even though they may be called something different and accessed differently. However, these functions constitute the idea of the outlining program, for example, Grandview has a "Reorganize" menu and PC-Outline has an "Outline" menu. Both menus perform similar functions associated with reorganizing the outline. In addition, PC-Outline allows you to delete and create new entries when in the "Outline" menu. As a comparison, Grandview offers four move functions compared to the single move function available in this menu on PC-Outline.

A review of the various nine menus available in each of the programs leads to the conclusion that the features/functions on PC-Outline and Grandview are similar in their essence, but quite different in their complementary features. The expression of the ideas inherent in the features are accordingly distinct.

Apparently, plaintiff is also asserting the use of pull down windows as a similarity. This idea is employed in a number of computer programs, including MORE! and Think-Tank. Plaintiffs may not claim copyright protection of an idea and expression that is, if not standard, then commonplace in the computer software industry. Plaintiff's copyright validly covers only "original works of authorship." 17 U.S.C. § 102(a); Roth Greeting Cards v. United Card Co., 429 F.2d 1106 [166 USPQ 291] (9th Cir. 1970). Originality although not defined by statute, requires independent creation, it means "only that the work owes its origin to the author, i.e., is independently created." Nimmer on Copyright, 2-8.1 § 2.01[A]. Although a presumption of originality attaches to a valid copyright registration, defendants have rebutted this presumption in this case. John L. Friend testified that he based his PC-Outline on ThinkTank. In light of the use of pull-downs in previous programs, plaintiff has failed to show that the pull down windows were original and independently created for PC- Outline.

In addition, the pull down windows look different. The lists in each menu are different. Although the two programs share the use of letter abbreviations as a means of selecting the desired option, the wording describing the functions are dissimilar.

Plaintiff cites the similarity of using the main editing screen to enter and edit data. The need to have a screen from which a user can perform editing functions is essential to the very idea of a computer outlining program. Brown Bag points to the expression of that concept as similar inasmuch as the

color shading is identical. Plaintiff admits that fewer than 10 of the 44 default color selections in the Grandview program are the same as the default color selections in the PC-Outline program. Nevertheless, plaintiff asserts that the choice of the blue background infringes on the PC-Outline copyright. Defendant submitted declarations from an expert describing the functional role of the blue background "relating to the physiology of the human eye, the characteristics of the computer video displays and the connotations of the color blue for financial and corporate institutions." The Rules of the Copyright Office also specifically exclude from copyright registration "typographic ornamentation, lettering or coloring." 37 C.F.R. § 202.1. Finally, the limited number of

12 USPQ2d 1996

background colors for computer programs precludes copyright protection for such choices. United States v. Hamilton, 583 F.2d 448, 451 [200 USPQ 14] (9th Cir. 1978).

The Court finds that it is unnecessary to review the alleged similarities in the drawing of the menu bar, the use of highlighting bars and the use of a single line box around the menus because these features are covered in the license agreement between plaintiff and John L. Friend.

[1] The Court's "analytic dissection" of plaintiff's alleged similarities shows that the majority of the alleged similarities pertain to features that are not protected under the copyright. However, plaintiff also spent considerable time pointing out the similarities between the two programs' open-

ing menus, beginning with the title, "opening menu." The use of an opening menu, named an opening menu, is itself an idea and not protectable. Nevertheless, once the ideas are found to be similar, the Court must review the expression of that idea on the screen.

[2] At first glance, the screen's announcements are quite distinct. Grandview's name is portrayed in large, block letters at the top of the screen. "Welcome to PC-Outline" is modestly placed at the top of plaintiff's program. The list of the opening menu options are quite distinct. Grandview offers seven options, PC-Outline offers four. Some of the functions are the same, opening or starting a new outline, accessing an existing outline, accessing the directory and quitting the program altogether. Nevertheless, these functions are inherent in the idea of a computer outlining program and are not protected under the copyright. The description of these functions is different. Additionally, Grandview allows the user to access the functions by hitting a key letter or by highlighting the function.

[3] The Court may issue summary judgment on the issue of substantial similarity if it finds that no reasonable jury could find "substantial similarity of both ideas and expression between the works at issue." Aliotti, 831 F.2d at 900 [4 USPQ2d at 1870]. The two screens share the same idea, they are used to access the various functions initially available to the user. However, the expression of the two screens are not substantially similar, as a matter of law. In addition, many of the expressions which plaintiff argues are substantially simi-

lar are either not protected under the copyright or were licensed to Mr. Friend.

Good cause appearing therefor, the Court HEREBY GRANTS the motion for summary judgment.

V. SUMMARY

Plaintiff has presented the Court with a computer software program designed to facilitate the creation and editing of outlines. The allegedly infringing work encompasses the same idea and performs the same general functions as plaintiff's PC-Outline. Plaintiff has provided the Court with a list of similarities between the two programs which allegedly render the look and feel of defendant's Grandview program substantially similar to PC- Outline. Inasmuch as plaintiff refers to the use of similar functions, the use of a main editing screen, a menu bar, pull-down windows and the color scheme of the programs, these features are unprotectable under the copyright laws or are licensed to John L. Friend pursuant to the written contract. Plaintiff may not rely on these features in proving its case at trial.

Plaintiff also claims that the look and feel of the opening screens are substantially similar in the two programs. After redacting that material which is not protected under the copyright, or which has been licensed to Mr. Friend, the Court performed the required extrinsic and intrinsic tests mandated by law. The Court finds that although the opening screens share similar ideas, the screens are, as a matter of law, not substantially similar. Plaintiff has failed to meet its evi-

dentiary proof on this matter. No reasonable jury could find that the screens are substantially similar.

Good cause appearing therefor, the Court GRANTS the motion for summary judgment.

IT IS SO ORDERED.

ORDER DISMISSING

STATE LAW CLAIMS

On August 23, 1989, the Court granted defendants' motion for summary judgment on the federal copyright claims. The only remaining claims are state law claims which depend on the federal copyright claim. The Court will not exercise its pendent jurisdiction over those state claims. Good cause appearing therefor, the Court HEREBY DISMISSES the pendent state law claims, without prejudice.

IT IS SO ORDERED.

JUDGMENT

Pursuant to its Order Granting Summary Judgment and its Order Dismissing State Law Claims, Judgment is HEREBY ENTERED for defendants.

IT IS SO ORDERED.

APPENDIX C

Magistrate's "Order on Symantec's Motion for a Protective Order" (March 8, 1989)

UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA SAN JOSE DIVISION

TELEMARKETING RESOURCES, a California corporation dba Brown Bag Software,

Plaintiff,

v

SYMANTEC CORPORATION, a California corporation, JOHN L. FRIEND, an individual and dba Softworks Development

Defendant.

And Related Counterclaim

NO. C 88-20352 RPA

ORDER ON SYMANTEC'S MOTION FOR A PROTECTIVE ORDER

Symantec's motion for a protective order came on for hearing on March 7, 1989. Defendant Friend joined in the motion.

Mitchell Zimmerman appeared for Symantec, Paul Warner appeared for John Friend and Brian Flynn appeared for plaintiff.

Good cause appearing therefor, IT IS HEREBY ORDERED that the motion for protection is GRANTED.

The stipulated protective order entered into by the clients and lawyers in this case anticipated that independent outside counsel have restricted access to confidential material designated "attorneys' eyes only" or "computer source code." At the time of the stipulated order all litigation counsel were outside counsel.

The plaintiff has sought the removal of its outside counsel and has designated its new and sole in-house counsel as counsel of record in this case. Plaintiff's in-house counsel is the first and only in-house counsel for Brown Bag Software. His responsibilities run the gamut of legal issues from personnel to intellectual property. Although clearly not a management employee, in-house

counsel's role is to advise management on all legal issues. He is also the corporation's Human Resource (personnel) person.

The stipulated protective order in this case clearly intended to prevent highly confidential information from being available to the parties. Under the circumstances of this case in-house counsel is so close to the party that the dangers of inadvertent disclosure of information is impossible to control.

The Court notes the good faith and integrity of in-house counsel in this case, however, he is in an untenable position as both litigation and in-house counsel.

The plaintiff is not precluded from prosecuting its case with counsel of its choice, however, it must seek the services of an independent consultant, legal or otherwise, to review and

advise on issues involving the "attorneys' eyes only" documents or the source code documents.

DATED:

/s/Patricia V. Trumbull
PATRICIA V. TRUMBULL
United States Magistrate

APPENDIX D

Judge's "Order Denying Motion for Extension of Discovery Cut-off Date and Denying Motion for Reconsideration of Magistrate's Ruling" (April 24, 1989)

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

TELEMARKETING RESOURCES,

Plaintiff,

vs.

SYMANTEC CORPORATION, a California corporation, JOHN L. FRIEND, an individual and dba Softworks Development

Defendant.

NO. C 88-20352 RPA

ORDER DENYING MOTION FOR EXTENSION OF DISCOVERY CUT-OFF DATE AND DENYING MOTION FOR RECONSIDERATION OF MAGISTRATE'S RULING

The Court has received, read and considered plaintiff's motions for 1) an extension of the discovery cut-off date and 2) reconsideration of the Magistrate's ruling. Good cause appearing therefor, the motions are DENIED.

On February 17, 1989, the Court denied defendant's motion to dismiss for lack of prosecution. At that time, the court in-

dicated the existing discovery cut-off date would be maintained and set forth a date for a summary judgment motion hearing. Defendant has failed to show due diligence or good cause why the discovery date should now be extended. Good cause appearing therefor, the motion to extend the discovery cut-off date is HEREBY DENIED. Nevertheless, plaintiff may complete all discovery commenced prior to the cut-off date.

Plaintiff's motion for reconsideration of the Magistrate's Order is HEREBY DENIED.

IT IS SO ORDERED.

DATED: April 24, 1989

/s/ Robert P. Aguilar
ROBERT P. AGUILAR
United States District Judge

APPENDIX E

U.S. Constitution

Art. 1, Sec. 8, Cl. 8. Patents and Copyrights.

To promote the progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

APPENDIX F

U.S. Constitution

AMENDMENT 5

No Person shall be held to answer for a capital, or otherwise infamous crime, unless on a presentment or indictment of a Grand Jury, except in cases arising in the land or naval forces, or in the Militia, when in actual service in time of War or public danger; nor shall any person be subject for the same offense to be twice put in jeopardy of life or limb; nor shall be compelled in any criminal case to be a witness against himself, nor be deprived of life, liberty, or property, without due process of law; nor shall private property be taken for public use, without just compensation.

APPENDIX G

U.S. Constitution

AMENDMENT 6

In all criminal prosecutions, the accused shall enjoy the right to a speedy and public trial, by an impartial jury of the State and district wherein the crime shall have been committed, which district shall have previously ascertained by law, and to be informed of the nature and cause of the accusation; to be confronted with the witnesses against him; to have compulsory process for obtaining witness in his favor, and to have the Assistance of Counsel for his defense.

APPENDIX H

United States Code, Title 17

§ 101. Definitions

As used in this title, the following terms and their forms mean the following:

An "anonymous work" is a work on the copies or phonorecords of which no natural person is identified as author.

An "architectural work" is the design of a building as embodied in any tangible medium of expression, including a building, architectural plans, or drawings. The work includes the overall form as well as the arrangement and composition of spaces and elements in the design, but does not include individual standard features.

"Audio-visual works" are works that consist of a series of related images which are intrinsically intended to be shown by the use of machines or devices such as projectors, viewers, or electronic equipment, together with accompanying sounds, if any, regardless of the nature of the material objects, such as films or tapes, in which the works are embodied.

The "Berne Convention" is the convention for the Protection of Literary and Artistic Works, signed at Berne, Switzerland, on September 9, 1886, and all acts, protocols, and revisions thereto.

A work is a "Berne Convention work" if--

(1) in the case of an unpublished work, one or more of the authors is a national of a nation adhering to the Berne Convention, or in the case of a published work, one or more of the authors is a national of a nation adhering to the Berne Convention on the date of first publication;

(2) the work was first published in a nation adhering to the Berne Convention, or was simultaneously first published in a nation adhering to the Berne Convention and in a foreign nation that does not adhere to the Berne Convention;

(3) in the case of an audio-visual work--

(A) if one or more of the authors is a legal entity, that author has its headquarters in a nation adhering to the Berne Convention; or

(B) if one or more of the authors is an individual, that author is domiciled, or has his or her habitual residence in, a nation adhering to the Berne Convention;

(4) in the case of a pictorial, graphic, or sculptural work that is incorporated in a building or other structure, the building or structure is located in a nation adhering to the Berne Convention; or

(5) in the case of an architectural work embodied in a building, such building is erected in a country adhering to the Berne Convention.

For purposes of paragraph (1), an author who is domiciled in or has his or her habitual residence in, a nation adhering to the Berne Convention is considered to be a national of that nation. For purposes of paragraph (2), a work is considered to have been simultaneously published in two

or more nations if its dates of publication are within 30 days of one another.

The "best edition" of a work is the edition, published in the United States at any time before the date of deposit, that the Library of Congress determines to be most suitable for its purposes.

A person's "children" are that person's immediate offspring, whether legitimate or not, and any children legally adopted by that person.

A "collective work" is a work, such as a periodical issue, anthology, or encyclopedia, in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole.

A "compilation" is a work formed by the collection and assembling of pre-existing materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship. The term "compilation" includes collective works.

A "computer program" is a set of statements or instructions to be used directly or indirectly in a computer in order to bring about a certain result.

"Copies" are material objects, other than phonorecords, in which a work is fixed by any method now know or later developed, and from which the work can be perceived repro-

duced, or otherwise communicated, either directly or with the aid of a machine or device. The term "copies" includes the material object, other than a phonorecord, in which the work is first fixed.

"Copyright owner," with respect to any of the exclusive rights comprised in a copyright, refers to the owner of that particular right.

The "country of origin" of a Berne Convention work, for purposes of section 411, is the United States if --

(1) in the case of a published work, the work is first published--

(A) in the United States;

(B) simultaneously in the United States and another nation or nations adhering to the Berne Convention, whose law grants a term of copyright protection that is the same as or longer than the term provided in the United States;

(C) simultaneously in the United States and a foreign nation that does not adhere to the Berne Convention; or

(D) in a foreign nation that does not adhere to the Berne Convention, and all of the authors of the work are nationals, domiciliaries, or habitual residents of, or in the case of an audiovisual work legal entities with headquarters in, the United States;

(2) in the case of an unpublished work, all the authors of the work are nationals, domiciliaries, or habitual residents of the United States, or, in the case of an unpublished audiovisual work, all the authors are legal entities with headquarters in the United States; or

(3) In the case of a pictorial, graphic, or sculptural work incorporated in a building or structure, the building or structure is located in the United States.

For the purpose of section 411, the "country of origin" of any other Berne Convention work is not the United States.

A work is "created" when it is fixed in a copy or phonorecord for the first time; where a work is prepared over a period of time, the portion of it that has been fixed at any particular time constitutes the work as of that time, and where the work has been prepared in different versions, each version constitutes a separate work.

A "derivative work" is a work upon one or more pre-existing works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modification which, as a whole, represent an original work of authorship, is a "derivative work."

A "device," "machine," or "process" is one now known or later developed.

To "display" a work means to show a copy of it, either directly or by means of a film, slide, television image, or any other device or process or, in the case of a motion picture or other audiovisual work, to show individual images non-sequentially.

A work is "fixed" in a tangible medium of expression when its embodiment in a copy of phonorecord, by or under

the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration. A work consisting of sounds, images, or both, that are being transmitted, is "fixed" for purposes of this title if a fixation of the work is being made simultaneously with its transmission.

The terms "including" and such as" are illustrative and not limitative.

A "joint work" is a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole.

"Literary works" are works, other than audiovisual works, expressed in words, numbers, or other verbal or numerical symbols or indicia, regardless of the nature of the material objects, such as books, periodicals, manuscripts, phonorecords, film, tapes, disks, or cards, in which they are embodied.

"Motion pictures" are audio-visual works consisting of a series of related images which, when shown in succession, impart an impression of motion, together with accompanying sounds, if any.

To "perform" a work means to recite, render, play, dance, or act it, either directly or by means of any device or process or, in the case of a motion picture or other audio-visual work, to show its images in any sequence or to make the sounds accompanying it audible.

"Phonorecords" are material objects in which sounds, other than those accompanying a motion picture or other audiovisual work, are fixed by any method now known or later developed, and from which the sounds can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. The term "phonorecords" includes the material object in which the sounds are first fixed.

"Pictorial, graphic, and sculptural works" include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of the utilitarian aspects of the article.

A "pseudonymous work" is a work on the copies or phonorecords of which the author is identified under a fictitious name.

"Publication" is the distribution of copies or phonorecords of a work to the public by sale or other transfer of ownership or rental, lease, or lending. The offering to distrib-

ute copies or phonorecords to a group of persons for purposes of further distribution, public performance, or public display, constitutes publication. A public performance or display of a work does not of itself constitute publication.

To perform or display a work "publicly" means-

(1) to perform or display it at a place open to the public or at any place where a substantial number of persons outside of a normal circle of a family and its social acquaintances is gathered; or

(2) to transmit or otherwise communicate a performance or display of the work to a place specified by clause (1) or to the public, by means of any device or process, whether the members of the public capable of receiving the performance or display receive in the same place or in separate places and at the same time or at different times.

"Sound recordings" are works that result from the fixation of series of musical, spoken, or other sounds, but not including the sounds accompanying a motion picture or other audiovisual work, regardless of the nature of the material objects, such as disk, tapes, or other phonorecords, in which they are embodied.

"State" includes the District of Columbia and the Common- wealth of Puerto Rico, and any territories to which this title is made applicable by an Act of Congress.

A "transfer of copyright ownership" is an assignment, mortgage, exclusive license, or any other conveyance, alienation, or hypothecation of copyright or any of the exclusive rights comprised in a copyright, whether or not it is limited

in time or place of effect, but not including a non-exclusive license.

A "transmission program" is a body of material that, as an aggregate, has been produced for the sole purpose of transmission to the public in sequence and as a unit.

To "transmit" a performance.or display is to communicate it by any device or process whereby images or sounds are received beyond the place from which the are sent.

The "United States," when used in a geographical sense, comprises the several States, the District of Columbia and the Commonwealth of Puerto Rico, and the organized territories under the jurisdiction of the United States Government.

A "useful article" is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a "useful article."

The author's "widow" or "widower" is the author's surviving spouse under the law of the author's domicile at the time of his or her death, whether or not the spouse has later remarried.

A "work of visual art" is--

(1) a painting, drawing, print, or sculpture, existing in a single copy, in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author, or, in the case of a sculpture, in multiple cast, carved, or fabricated

sculptures of 200 or fewer that are consecutively numbered by the author and bear the signature or other identifying mark of the author; or

(2) a still photographic image produced for exhibition purposes only, existing in a single copy that is signed by the author, or in limited edition of 200 copies or fewer that are signed and consecutively numbered by the author.

A work of visual art does not include--

(A)(i) any poster, map, globe, chart, technical drawing, diagram, model, applied art, motion picture or other audiovisual work, book, magazine, newspaper, periodical, data base, electronic information service, electronic publication, or similar publication;

(ii) any merchandising item or advertising, promotional, descriptive, covering, or packaging material or container;

(iii) any portion or part of any item described in clause (i) or (ii);

(B) any work made for hire; or

(C) any work not subject to copyright protection under this title.

A "work of the United States Government" is a work prepared by an officer or employee of the United States Government as part of that person's official duties.

A "work made for hire" is-

(1) a work prepared by an employee within the scope of his or her employment; or

(2) a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas, if the parties expressly agree in a written instrument signed by them

that the work shall be considered a work made for hire. For the purpose of the following sentence, a "supplementary work" is a work prepared for publication as a secondary adjunct to a work by another author for the purpose of introducing, concluding, illustrating, explaining, revising, commenting upon, or assisting in the use of the other work, such as forewords, afterwards, pictorial illustrations, maps, charts, tables, editorial notes, musical arrangements, answer material for tests, bibliographies, appendixes, and indexes, and an "instructional text" is a literary, pictorial, or graphic work prepared for publication and with the purpose of use in systematic instructional activities.

APPENDIX I

United States Code, Title 17

§ 102. Subject matter of copyright: In general

(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

(1) Literary works;
(2) musical works, including any accompanying words;
(3) dramatic works, including any accompanying music;
(4) pantomimes and choreographic works;
(5) pictorial, graphics, and sculptural works;
(6) motion pictures and other audiovisual works;
(7) sound recordings; and
(8) architectural works.

(b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

APPENDIX J

United States Code, Title 17

§ 103. Subject matter of Copyright: Compilations and derivative works

(a) The subject matter of copyright as specified by section 102 includes complications and derivative works, but protection for a work employing preexisting material in which copyright subsists does not extend to any part of the work in which such material has been used unlawfully.

(b) The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.